

DOES A SONG BY ANY OTHER NAME STILL SOUND AS SWEET?: DIGITAL SAMPLING AND ITS COPYRIGHT IMPLICATIONS

RANDY S. KRAVIS

"So sampling is theft, right?"¹

TABLE OF CONTENTS

Introduction	232
I. Digital Sampling	237
II. Copyright Law	239
A. What Qualifies for Copyright Protection?	240
B. Rights of the Copyright Owner	241
C. Infringement	243
1. Ownership	244
2. Copying	244
a. Access	245
b. Substantial similarity	245
3. The defense of fair use	246
D. Remedies	248
III. The Controversy Surrounding Digital Sampling	250
A. The Debate Over Substantial Similarity	250
B. The Debate Over Originality	255
C. The Debate Over the Effect of Sampling on a Song's Market	258
D. The Copyright Act's Ambiguous Legislative History .	260
IV. The Case: <i>Grand Upright Music Ltd. v. Warner Bros. Records, Inc.</i>	262
A. The Factual Background	263

1. J.D. Considine, *Larcenous Art*, ROLLING STONE, June 14, 1990, at 107, 107-09 (discussing controversy of whether sampling is "simple theft" or "appropriate artistic response to expanding technology").

B. The Opinion	263
V. The Effect of <i>Grand Upright Music</i> on the Law Regarding Digital Sampling	265
A. The Decision's Effect on the Law Regarding Digital Sampling	265
B. How the Decision Will Influence the Law Regarding Digital Sampling	266
1. The impact on the questions of law presented by digital sampling	266
2. The impact on the music industry	269
VI. Solutions	271
A. Congress Should Amend the Copyright Act	271
B. Congress Should Institute a Compulsory Licensing Provision for Digital Sampling	273
Conclusion	275

INTRODUCTION

Much controversy has emerged over the new technology of digital sampling.² Simply put, sampling is the process that recording artists use to include previously recorded portions of another artist's work in a new recording.³ While some people in the music industry believe that sampling without permission is tantamount to stealing,⁴ others view sampling as an art form no more plagiaristic than any

2. See Don Snowden, *Sampling: A Creative Tool or License to Steal?*, L.A. TIMES, Aug. 6, 1989, (Calendar), at 61 (describing heated debate created by growing popularity of rap music and attendant increase in sampling).

3. See *infra* notes 32-48 and accompanying text (describing science and development of digital sampling technology).

4. See Snowden, *supra* note 2, at 61 (articulating belief of one musician that there is "trouble" in sampling other artists' work). As one might expect, many of the artists who equate sampling with stealing are the same artists whose songs are being sampled. In commenting on the use of a sound from his song in a love ballad by another artist, prominent soul artist James Brown said angrily, "Anything they take off my record is mine. Is it all right if I take some paint off your house and put it on mine? Can I take a button off your shirt and put it on mine? Can I take a toenail off your foot—is that all right with you?" For example, David Korteling, guitarist for the local Atlanta band Second Nature, strongly disapproves of sampling and believes other local musicians feel the same way. Interview with David Korteling, in Atlanta, Ga. (Nov. 11, 1992). See also Molly McGraw, *Sound Sampling Protection and Infringement in Today's Music Industry*, 4 HIGH TECH. L.J. 147, 152 (1989). Many lesser known regional artists are also critical of sampling. One sound engineer, whose job it is to actually do the sampling, has expressed moral disdain for the practice. See McGraw, *supra*, at 152 (quoting sound engineer Tom Lord-Alge as saying, "We're all blatantly stealing from everyone else"). Even musicians who favor sampling have noted that excessive use can be theft. See Jeffrey Ressler, *Sampling Amok?*, ROLLING STONE, June 14, 1990, at 103, 105 (quoting funk artist George Clinton as saying that DJs who sample extended portions of music are simply "bootlegging").

other.⁵ The popularity of "rap" music,⁶ which relies heavily on the use of sampling,⁷ has pushed the technique into the spotlight of the music industry.⁸ As a result, a debate has arisen over the practice of sampling and its legal implications.⁹

5. See Ressler, *supra* note 4, at 103 (discussing arguments by sampling advocates that all new music is influenced by previous music in some way and that very few musical pieces are completely original). Ken Anderson, a lawyer for rap artist Tommy Boy, rationalizes sampling as follows: "All new music comes from old music in one way or another. It should be the American way to err on the side of artistic freedom." *Id.* Justice Story's famous opinion in *Emerson v. Davies*, 8 F. Cas. 615 (C.C.D. Mass. 1845) (No. 4436), may bear out this notion:

In truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. . . . [E]ven Shakespeare and Milton, so justly and proudly our boast as the brightest originals would be found to have gathered much from the abundant stores of current knowledge and classical studies in their days.

Id. at 619. Justice Story's perspective supports the argument that, because all new music inherently borrows from previous music, sampling in rap music is no more larcenous than other forms of music.

6. Melinda Henneberger & Michael Marriott, *For Some, Rituals of Abuse Replace Youthful Courtship*, N.Y. TIMES, July 11, 1993, at A1 (noting uniform popularity of rap among teenagers); David Mills, *Pop Recordings: Rappers to Watch, Simply Kickin' It!*, WASH. POST, Feb. 3, 1991, at G3 (stating that rap music has become "dominant element of the American youth culture"). Rap's popularity is clearly reflected in the amount of album sales rap and hip-hop artists generate. See Teresa Moore & Torri Minton, *Music of Rage*, S.F. CHRON., May 18, 1992, at 1 (reporting that rap has increased from 11.6% of \$5.5 billion in music sales in 1987 to 18.3% of \$7.5 billion spent in 1990). Rappers Vanilla Ice, with "To the Extreme," and M.C. Hammer (who has since dropped the "M.C." from his name), with "Please Hammer, Don't Hurt 'Em," have each sold over 10 million copies. Gary Graff, *Rap or Pop?*, CHI. TRIB., June 11, 1992, at 10D.

7. See John Leland, *The Mover vs. the Rapper*, NEWSWEEK, Jan. 6, 1992, at 55 (stating that most rap music uses samples). In fact, rap artists were sampling prior to the existence of that term when they created what is presently known as rap music. See Snowden, *supra* note 2, at 62 (noting that early rappers created their own lyrics to accompany prerecorded songs or rhythm tracks). Two albums released in 1979, "Rappers' Delight" by the Sugar Hill Gang and the self-titled album "Fatback and their DJ, Big Tim III," revolutionized rap music by first using previously recorded music. See DAVID TOOP, *THE RAP ATTACK: AFRICAN JIVE TO NEW YORK HIP-HOP 15-16* (1984) (discussing rap's origins); Jason H. Marcus, Note, *Don't Stop That Funky Beat: The Essentiality of Digital Sampling to Rap Music*, 13 HASTINGS COMM. & ENT. L.J. 767, 770-72 (1991) (explaining that both Sugar Hill Gang and Fatback and their DJ, Big Tim III borrowed heavily from "Good Times" by disco group Chic); Snowden, *supra* note 2, at 62 (stating that "many early hits in the [rap] genre were built around the bass line to 'Good Times' by Chic"). Since then, rappers have widely used samples in their songs. See Sheila Rule, *Record Companies Are Challenging 'Sampling' in Rap*, N.Y. TIMES, Apr. 21, 1992, at C13 (calling sampling "prime element" of rap music); Snowden, *supra* note 2, at 62 ("Sampling has been a natural avenue for rappers, since the style began with artists creating their own lyrics to the accompaniment of cassette tapes of songs or skeletal rhythm tracks.").

8. See generally Lee Jeske, *The Marriage of Jazz and Hip-Hop: Is This May-December Union Producing Legit Musical Offspring?*, BILLBOARD, July 3, 1993, at J10 (calling royalty clearance for samples "a hip-hop problem"); Leland, *supra* note 7, at 55 (noting that "cottage industry" has arisen to authorize clearance to use samples); Amy Singer, *Dream Job at the Top of the Charts*, AM. LAW., Apr. 1991, at 48, 51 (noting that when song that uses unauthorized sample is commercially successful, company holding copyright to sampled song will take notice and seek payment).

9. See generally *infra* notes 130-88 (examining arguments both for and against digital sampling). Until recently, the debate over sampling has taken place everywhere but in the courts or in Congress, two arenas likely to provide answers to the questions over digital sampling. See *infra* note 26 and accompanying text (discussing dearth of digital sampling cases).

The primary area of debate focuses on the Copyright Act of 1976.¹⁰ The Act governs the making and the use of artistic creations such as books, works of art, and musical compositions.¹¹ Although it requires artists to obtain permission before using another's sound recordings in certain instances,¹² for the most part, the Act is ill-equipped to deal effectively with digital sampling. Congress simply could not have foreseen the myriad of issues that the advanced technology of sampling would present.¹³

For example, sampling transcends the scope of the "substantial similarity" test¹⁴ as it was originally conceived.¹⁵ Substantial similarity is one of the tests that the Copyright Act uses to determine whether use of a copyrighted song constitutes "fair use."¹⁶ Congress intended the substantial similarity test to determine whether a re-creation or

10. 17 U.S.C. §§ 101-914 (1988 & Supp. IV 1992).

11. See 17 U.S.C. § 102(a) (1988) (listing categories that constitute protected "works of authorship").

12. See *id.* (granting copyright owner exclusive rights to reproduce copyrighted work, to prepare derivative works, and to sell recorded copies of work).

13. See Ressler, *supra* note 4, at 105 (addressing problem of technology outpacing law). Ressler quotes Eric Greenspan, an entertainment lawyer who represents Daddy-O of Stetasonic, Prince Paul, and other rappers, as saying, "What we're trying to do is interpret old laws for new circumstances. The problem is that technology is moving faster than lawyers and managers can react." *Id.*; see also *Digital Sampling Cheered, Jeered*, CHI. TRIB., Oct. 23, 1986, § 6, at 10 ("Sound sampling is the epitome of technology trying to squeeze into copyright law where it just doesn't fit.") (quoting attorney M. William Krasilovsky); Steven Dupler, *Digital Sampling: Is It Theft?*, BILLBOARD, Aug. 2, 1986, at 1, 74 (quoting record producer Arif Mard as saying that law cannot keep up with technology, especially when specific technology, like sampling, is difficult to understand).

The Supreme Court has recognized the continuing problem of technology outgrowing the law. Prior to 1976, the Court struggled to apply the outdated, but still extant, Copyright Act of 1909. See, e.g., *Goldstein v. California*, 412 U.S. 546, 564 (1973) (concluding that technology differed so greatly from that which existed in 1909 that Copyright Act of 1909 was inapplicable); *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390, 395-96 (1968) (acknowledging that inquiry into cable television case could not be limited to ordinary meaning of 1909 Act because Congress drafted 1909 Act long before development of television). Even after Congress amended the Copyright Act in 1976, the Court continued to address the race between technology and law. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984) (stating that "the law of copyright has developed in response to significant changes in technology").

Even Congress has recognized that the 1976 Act is unable to cope with the advances in technology. See *Copyright and Technological Change: Hearings Before the Subcomm. on the Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary*, 98th Cong., 1st Sess. 20 (1983) (testimony of Frederick Weingarten, Program Manager, Communication & Information Technologies Program, Office of Technology Assessment) (explaining that new law is necessary to protect creators in light of new technology).

14. See *infra* notes 91-96 and accompanying text (describing "substantial similarity" test as presented in 1976 Copyright Act and as interpreted by courts).

15. See *infra* note 17 and accompanying text (reviewing Congress' legislative intent); J.C. Thom, Comment, *Digital Sampling: Old-Fashioned Piracy Dressed Up in Sleek New Technology*, 8 LOY. ENT. L.J. 297, 326 (1988) (arguing that substantial similarity test is inapplicable to sound recordings).

16. See *infra* notes 97-111 and accompanying text (discussing elements of fair use defense under § 107 of Copyright Act).

imitation of a copyrighted work uses too much of the original work.¹⁷ Sampling, however, does not involve the imitation of sounds, but rather the use of a portion of another artist's actual original work.¹⁸ Similarly, digital sampling presents questions of both law and policy as to what originality means under copyright law.¹⁹ Proponents of sampling argue that the manipulation of a previous sound into a new song is an art form in itself, thereby making the new song an original work of art.²⁰

Another test that the Copyright Act uses to determine whether a use is a fair use is the "effect on the market" test, which asks whether the imitation or re-creation of a copyrighted song adversely affects the market for the copyrighted song.²¹ Again, when it formulated the effect on the market test, Congress did not and could not have taken into account sampling, where actual sounds of a song are used.²² Some commentators have questioned whether Congress would have outlawed digital sampling under the Act if it could have foreseen the advent of such technologies.²³ Nevertheless, because Congress could not have considered the unique nature of sampling when it created and last amended the Act, legal scholars must analyze digital sampling without direct congressional guidance.²⁴

Surprisingly, despite the confusion, debate, and controversy surrounding sampling and its widespread use, it was not until December 1991 in *Grand Upright Music Ltd. v. Warner Bros. Records*,

17. The legislative history of the 1909 Act, which first addressed the issue of substantial similarity, indicates that Congress focused on "imitation" when formulating the test. See H.R. REP. NO. 2222, 60th Cong., 2d Sess. 106 (1909) (stating that "mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible") (emphasis added).

18. See *infra* notes 31-37 and accompanying text (describing sampling process as one that extracts sounds from existing recordings and places them in new recordings).

19. See *infra* notes 54-60 and accompanying text (describing originality requirement created by courts as mandating "independent creation" and "more than mere trivial variation," but not requiring "uniqueness" or "novelty").

20. See *infra* notes 151-66 and accompanying text (discussing whether songs that use sampled music are original works of art and whether sampling itself is form of art).

21. See *infra* notes 110-11 and accompanying text (discussing effect on market test and explaining that test is one of four factors courts weigh in determining fair use).

22. Digital sampling was not available to the public at the time Congress codified the various tests in the 1976 Copyright Act. See David Sanjek, "Don't Have to DJ No More": Sampling and the "Autonomous" Creator, 10 CARDOZO ARTS & ENT. J. 607, 612 (1992) (explaining that digital sampling originated in 1983).

23. See *infra* text accompanying notes 180-88 (discussing speculative debate over whether Congress would have supported digital sampling had sampling existed in 1976).

24. See Lionel Bently, *Sampling and Copyright: Is the Law on the Right Track?* - I, 1989 J. BUS. L. 113, 113-25 (analyzing sampling using current law); McGraw, *supra* note 4, at 147-69 (discussing digital sampling in framework of current law).

*Inc.*²⁵ that a court handed down the first decision regarding the use of sampling.²⁶ In that case, Judge Kevin Duffy for the U.S. District Court for the Southern District of New York enjoined the production and sale of rap artist Biz Markie's album "I Need a Haircut" because it contained sampled portions of Gilbert O'Sullivan's 1972 hit "Alone Again (Naturally)."²⁷ In addition to issuing the injunction, Judge Duffy referred the case to the U.S. Attorney for consideration of possible criminal penalties.²⁸

The *Grand Upright Music* decision is significant for two reasons. First, the Southern District of New York, which issued the opinion, handles a large percentage of this country's copyright cases; thus the court has a substantial impact on copyright law.²⁹ Second, the decision is the first and, so far, the only judicial attempt to provide guidance on applying current copyright law to digital sampling.³⁰

This Note addresses the issues that the music industry and the legal community face with regard to digital sampling. Part I provides background on digital sampling by examining sampling from a technical standpoint. Part I also explains how and why sampled music has become so popular. Part II focuses on the 1976 Copyright Act and discusses its effect on samplers and samplees. Part III examines the controversy and debate leading up to the *Grand Upright Music* decision. In particular, this Part provides a detailed review of the difficulties that have arisen as a result of the music industry's attempt to apply both law and policy to digital sampling. Part IV outlines the facts of *Grand Upright Music* and traces the judge's reasoning in the

25. 780 F. Supp. 182 (S.D.N.Y. 1991).

26. The few sampling cases filed prior to *Grand Upright Music* were either settled out of court or dismissed. See Note, *A New Spin on Music Sampling: A Case for Fair Pay*, 105 HARV. L. REV. 726, 727-28 (1992) (explaining that parties often opted for settlement because litigation costs were so high). One reason for the lack of litigation is that the music industry established an ad hoc licensing system whereby artists bargained with other artists for the right to use samples. *Id.* The system was much less costly and time consuming than litigation; consequently, artists did not need litigation to resolve sampling disputes. *Id.*

27. *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 185 (S.D.N.Y. 1991) (citing "callous disregard" for copyright law as reason for injunction).

28. *Id.* (finding that defendant's knowledge of law requiring artists to obtain release before using song and subsequent disregard of this requirement may be grounds for possible criminal prosecution).

29. See *infra* note 211 and accompanying text (arguing that *Grand Upright Music* will have large legal impact by virtue of fact that Southern District of New York is leading district for copyright cases).

30. See *supra* note 26 and accompanying text (discussing lack of digital sampling cases). Congress probably intended for the courts to define the law regarding unforeseen technological advances such as sampling. See H.R. REP. NO. 1476, 94th Cong., 2d Sess. 66 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5680 (indicating that Congress intentionally kept doctrine of fair use vague and open so that courts would "be free to adapt the doctrine to particular situations on a case-by-case basis").

decision, while Part V discusses the impact of the case on the music industry. Here, the Note argues that the decision fails to address most of the copyright issues presented by digital sampling, but concludes that the *Grand Upright Music* decision will have (and to some extent already has had) a significant effect on the use of sampling and the music industry as a whole. Finally, Part VI recommends that Congress amend the Copyright Act to clarify the law on digital sampling, and suggests that Congress implement a compulsory licensing provision for digital sampling to support the goals of public access to works of art and protection of copyright owners' rights.

I. DIGITAL SAMPLING

Digital sampling is "the practice of using a portion of a previous sound recording in a new recording."³¹ The process can be broken down into three steps: digital recording, computer sound analysis, and playback.³² In the digital recording stage, analog sound waves³³ from sound recordings are converted into digital codes³⁴ that are

31. Robert G. Sugarman & Joseph P. Salvo, *Sampling Litigation in the Limelight*, 207 N.Y. L.J. 1, 1 (1992).

32. See Jeffrey R. Houle, *Digital Audio Sampling, Copyright Law and the American Music Industry: Piracy or Just a Bad "Rap"?*, 37 LOY. L. REV. 879, 880-81 (1992) (listing and describing three-step digital sound sampling process); Bruce J. McGiverin, Note, *Digital Sound Sampling, Copyright and Publicity: Protecting Against the Electronic Appropriation of Sounds*, 87 COLUM. L. REV. 1723, 1724 (1987) (listing digital recording, computer analysis, and playback as three stages of digital sound sampling); Ronald M. Wells, Comment, *You Can't Always Get What You Want But Digital Sampling Can Get What You Need!*, 22 AKRON L. REV. 691, 699-700 (1989) (discussing three-step sampling process).

33. Sound is merely "a pressure fluctuation in the air." Max V. Mathews & John R. Pierce, *The Computer as a Musical Instrument*, SCI. AM., Feb. 1987, at 126. Graphically, the pressure fluctuations that create sound are represented as waveforms. When these pressure fluctuations hit the ear, they are translated into nerve impulses that the brain interprets as sound. See Jeffrey S. Newton, *Digital Sampling: The Copyright Considerations of a New Technological Use of Musical Performance*, 11 HASTINGS COMM. & ENT. L.J. 671, 671 (1989) (describing physical properties of sound waves). Because of the wavelike properties of sound, each sound has its own frequency measured by the number of cycles of waves per second, also known as Hertz. McGraw, *supra* note 4, at 148 n.7. The frequency determines the pitch of the sound, which, in turn, determines the musical note. *Id.* For example, if one plays an A above middle C on a string instrument, the strings would vibrate 440 times per second (i.e., 440 Hertz). *Id.*

34. The digital sound recording stage involves the conversion of sound waves into binary digital units, known as bits, which are the building blocks that make up the digital code. See Houle, *supra* note 32, at 881 (describing analog-to-digital conversion process). Bits are the "smallest unit of information that a computer can recognize." CHARLES A. DODGE & THOMAS A. JERSEY, *COMPUTER MUSIC: SYNTHESIS, COMPOSITION AND PERFORMANCE* 3 (1985). Bits, represented by a numerical value (1 or 0), are stored in the computer's memory. A digital recording of a song, therefore, is nothing more than a series of 1s and 0s that relate musical sounds to the computer in a way that the computer can understand. See McGiverin, *supra* note 32, at 1724 (calling digitally recorded song "a series of binary values").

intelligible to a digital computer.³⁵ Once in this form, the sounds can then be altered and manipulated by rearranging the codes.³⁶ Finally, those sounds are played back and mixed with other songs with the touch of a keyboard.³⁷

While the use of the sampling process is a fairly recent phenomenon,³⁸ digital sampling actually traces its roots back to the 1960s when disc jockeys (DJs) began experimenting with "dub," a form of art created when DJs mix different sounds together into a single musical work.³⁹ Dub originated in Jamaica, where DJs mixed Jamaican and non-Jamaican records together.⁴⁰ It continued to be solely a Jamaican practice until a Jamaican-born DJ named Kool DJ Herc, along with other early DJs, introduced dub in the United States

35. See Judith G. Finell, *How a Musicologist Views Digital Sampling Issues*, 207 N.Y. L.J. 5, 7 n.3 (1992) (noting that any machine with digital data processing capabilities can convert analog sound waves into digital codes). Most often, samplers use standard personal computers or computerized synthesizers because they generally possess the capabilities needed for sampling. See Tamara J. Bynam, *Digital Sound Sampling and a Federal Right of Publicity: Is It Live or Is It Macintosh?*, 10 COMPUTER/L.J. 365, 366 (1990) (discussing pervasiveness of computer in music industry); Rich Malloy & Tom Thompson, *Tandy's 1000 Learns to Speak and Listen*, BYTE, Sept. 1988, at 158 (presenting latest model in personal computers with built-in analog-to-digital conversion capabilities). Samplers also use standard analog-to-digital converters to convert sound waves into codes. See *Analog Offers 16-Bit Sampling ADC*, 35 ELEC. NEWS 32, 32 (1989) (describing new analog-to-digital converter model).

The general physical process of digital sound recording is as follows: first, an engineer sends the sound through a microphone to the computer. See Houle, *supra* note 32, at 881 (noting vast difference between mechanism of digital sound sampling, which sends sound to analog-to-digital converter, and analog recording, which sends sound signals to transducer). Next, the built-in or attached analog-to-digital converter changes the sounds into a digital code which can be stored on a floppy disk or hard drive. See McGraw, *supra* note 4, at 150 (explaining how digitized signal of music can be captured on floppy disk or hard drive, simplifying process of attaining "ideal" sound). Once stored, the sampler can electronically alter the sounds or play them back. *Id.*

36. See David Goldberg & Robert Bernstein, *Music Copyrights and the New Technologies*, 199 N.Y. L.J. 1, 1-2 (1988) (stating that ability to alter sounds is "limited only by the user's imagination"); Houle, *supra* note 32, at 881 (discussing samplers' ability, once they have recorded sounds digitally, to "vary, delete, or reverse certain tonal qualities"); McGiverin, *supra* note 32, at 1725 (describing how samplers can convert pitch and timing of sampled notes, while still preserving notes' distinct tonal qualities).

37. See Considine, *supra* note 1, at 108-09 (noting that once code is converted back to sound, sampler may use synthesizer keyboard to play back particular sound when key is hit); Malloy & Thompson, *supra* note 35, at 158 (presenting computer with analog/digital circuitry that enables it to digitize and play back sounds).

38. See *infra* notes 42-48 and accompanying text (discussing development of sampling technology).

39. See Sanjek, *supra* note 22, at 610-11 (stating that dub originated when DJs "began to chant over the records, scatting or toasting improvised sets of lyrics"). In time, DJs began to discover that they could also alter various elements such as the bass and vocal tracks or add reverberation and echo. *Id.* at 611. The result was dub, a new art form in which live performers would chant lyrics over a recorded song that had been substantially altered from its original form. *Id.*

40. See Sanjek, *supra* note 22, at 610-11 (describing how portable sound systems in Jamaica allowed DJs to engage in competitive innovation of dubbing at mobile discotheques).

by experimenting with early sound techniques that would become precursors to modern-day sampling.⁴¹

It was not until the digital MIDI synthesizer⁴² came on the market in 1981, the same time that two revolutionary rap albums were released,⁴³ that digital sampling was born.⁴⁴ As a result of this technological innovation, the potential for experimentation with prerecorded music became endless.⁴⁵ The only barrier to such possibilities was the price of the electronic sampling equipment.⁴⁶ By the mid-1980s, however, sampling technology became more widespread, the prices of sampling equipment decreased, and almost all artists had sampling equipment at their disposal.⁴⁷ Consequently, popular artists have emerged who often rely on sampled material.⁴⁸

II. COPYRIGHT LAW

The Copyright Act of 1976,⁴⁹ which is the statutory body of law governing digital sampling,⁵⁰ addresses four main issues: (1) What qualifies for copyright protection?; (2) If a work qualifies for

41. See Sanjek, *supra* note 22, at 611 (listing Theodore, Afrika Bambaataa, and Grandmaster Flash as American DJs who, along with Kool DJ Herc, made dubbing popular practice in 1970s). These early techniques further evolved in the 1970s as DJs continued to experiment. See *id.* (mentioning that early DJs created experimental techniques, such as scratching record quickly on one groove, emphasizing pulse of records by adding beat box, and allowing one record to flow into next so that there is no break in music, that have become common on current rap albums). Being a DJ was artistically limiting, however, because manual dexterity dictated a DJ's skill. See *id.* at 612 (noting that because all DJs performed their new techniques manually, speed of performance limited them in what type of experiments they could do with songs).

42. The system of electrical equipment needed for sampling is often called a Musical Instrument Digital Interface (MIDI). Sanjek, *supra* note 22, at 612.

43. See *supra* note 7 (describing revolution in rap music brought about by albums that relied on previously recorded music).

44. See Sanjek, *supra* note 22, at 612 (crediting American company called Sequential Circuits with engineering first working digital sampling system in 1983); cf. McGraw, *supra* note 4, at 149 (explaining that first successful experiments with analog-to-digital conversion took place in mid-1960s when Dr. Max Mathews at New Jersey's Bell Laboratories constructed computer that converted analog sounds to digital signals). Unfortunately, the huge cost and size of the computer confined Dr. Mathews' work to the laboratory. *Id.*

45. See *supra* note 36 (discussing technological capabilities digital sampling presents).

46. See Snowden, *supra* note 2, at 64 (stating that initially, computerized keyboards needed for sampling ranged in price from \$50,000 to \$300,000).

47. See Sanjek, *supra* note 22, at 612 (explaining that price of MIDI synthesizer has become low enough for most DJs to afford); Steven Dupler, *Digital Sampling Prices*, BILLBOARD, Aug. 2, 1986, at 74, 74 (reporting that in 1986, some New York City discount shops were selling Casio's SK-1 sampling micro-keyboard for just \$98); Snowden, *supra* note 2, at 62 (noting that by late 1980s prices of sampling keyboards had dropped considerably to affordable range).

48. See *supra* note 8 (discussing popular music's increasing use of sampling).

49. 17 U.S.C. §§ 101-810 (1988).

50. See 17 U.S.C. § 102(a) (1988) (protecting "original works of authorship fixed in any tangible medium of expression" and stating that sound recordings and musical compositions are "works of authorship"). The Constitution grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST., art. I, § 8, cl. 8.

protection, what rights does the owner of the copyright have with respect to the work?; (3) What constitutes infringement of that copyright?; and (4) If infringement is found, what remedies are available to the copyright owner? This Part addresses each question separately.

A. *What Qualifies for Copyright Protection?*

The 1976 Copyright Act protects only "original works of authorship fixed in any tangible medium of expression."⁵¹ Thus, for a work to qualify for copyright protection, it must satisfy certain criteria. First, a "work of authorship" must be at issue. The Act specifically lists seven categories that constitute works of authorship: literary works; dramatic works; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and audiovisual works; and sound recordings.⁵² Sampled songs are works of authorship because, as "musical . . . works," they fall under the category of "sound recordings."⁵³

Second, only "original" works of authorship receive copyright protection under the Act.⁵⁴ The Act itself does not define "original"; the courts, however, are in general agreement that the originality threshold is a very low one.⁵⁵ In *L. Batlin & Son, Inc. v. Snyder*,⁵⁶ for example, the U.S. Court of Appeals for the Second Circuit held that an author need only contribute something more than a "merely trivial" variation for the court to consider the work at issue to be

51. 17 U.S.C. § 102(a) (1988 & Supp. III 1991).

52. *Id.*

53. Section 101 of the Act defines "sound recordings" as "works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied." 17 U.S.C. § 101 (1988).

Unlike the sound recording that must be embodied on "disks, tapes, or other phonorecords," *id.*, a musical work, which is the actual composition, may be and often is simply written down as musical notes on paper. See NEIL BOORSTYN, COPYRIGHT LAW § 2:18 (1981) (discussing copyrightability of sound recordings). As a result of this distinction, a recorded song has two separate copyrights, one in the sound recording and the other in the musical work. *Id.* Often, two separate companies hold one of the two copyrights. See Note, *supra* note 26, at 727 (stating that record companies usually own copyright to sound recordings and that music publishing companies usually hold musical work copyrights).

54. See 17 U.S.C. § 102(a).

55. See, e.g., *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 409-10 (2d Cir. 1970) (stating that "required creativity for copyright is modest at best"), *cert. denied*, 401 U.S. 977 (1971); *Moore v. Lighthouse Publishing Co.*, 429 F. Supp. 1304, 1308 (S.D. Ga. 1977) (proclaiming that "test of originality is one of low threshold" in case that questioned originality of city map); *Jacobs v. Robitaille*, 406 F. Supp. 1145, 1149-50 (D.N.H. 1976) (ruling that only minimal amount of creativity is necessary to support copyright).

56. 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).

original.⁵⁷ The author's work simply has to be "recognizably his own."⁵⁸ An original work must also possess "independent creation," but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty.⁵⁹ Rather, an original work simply must be a distinguishable creation of the author.⁶⁰

Third, copyright law does not protect ideas, but expressions of those ideas in fixed forms.⁶¹ Thus, only ideas reduced to concrete form are copyrightable. For example, a copyright extends to the arrangement of words in a book, but not to the idea conveyed by the words.⁶² Similarly, a tune or melody that an individual hums is not protected. To gain protection, the melody must be recorded.⁶³

B. Rights of the Copyright Owner

Once an author has met the criteria for establishing a valid copyright and has completed the proper copyright registration procedure,⁶⁴ the author then has certain exclusive rights under § 106 of the Act with respect to the copyrighted work.⁶⁵ These exclusive

57. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).

58. *Id.* at 490. *L. Batlin & Son, Inc.*, an importer of "Uncle Sam" piggybanks, attempted to restrain an importer of similar banks from exercising an allegedly invalid copyright that would interfere with Batlin's copyright. *Id.* at 486. The court held that the copyright in question was in fact invalid because the bank design was too similar to Batlin's bank, despite the fact that one bank was iron while the other was plastic. *Id.* at 486-89.

59. *Id.* at 490; *see also Mazer v. Stein*, 347 U.S. 201, 218 (1954) (holding that statuettes of male and female dancing figures, although copies of other works of art, were not misuse of copyright when used as part of manufactured article (bases for lamps) because copyright protects originality, not novelty).

60. *See Dorsey v. Old Surety Life Ins. Co.*, 98 F.2d 872, 873 (10th Cir. 1938) (stating that "[t]o be copyrightable a work must be original in that the author has created it by his own skill, labor, and judgment").

61. *See* 17 U.S.C. § 102(a) (1988) (explaining that concept of fixation "determines whether the provisions of the statute apply to a work"); *Mazer*, 347 U.S. at 217 (repeating well-known maxim that law protects only expression of idea, not idea itself).

62. *See Suid v. Newsweek Magazine*, 503 F. Supp. 146, 147 (D.D.C. 1980) (ruling that magazine article's reliance on book about John Wayne did not constitute infringement because copyrighting does not protect ideas, but actual form used to express ideas).

63. *See* 17 U.S.C. § 102(a) (1988) (mandating that work be "fixed in any tangible medium of expression to be protected"). It should be noted that, as a rule, a recording of an artist's live performance is not protected under the Copyright Act because a live performance is not fixed. *See id.* § 101 (defining performance of work as simply transmission or display of work); *see also McGiverin, supra* note 32, at 1727 (stating that copyright protection does not extend to sampling of live performance). There is, however, an exception to this rule; § 101 states that a "work consisting of sounds, images, or both that are being transmitted, is 'fixed' for purposes of this title if a fixation of the work is being made simultaneously with its transmission." 17 U.S.C. § 101 (1988). Thus, an artist can obtain a copyright for a live performance if the performance is recorded.

64. *See Wells, supra* note 32, at 694 (describing five-step procedure for copyright registration, including filing and submitting of application along with filing fee).

65. *See* 17 U.S.C. § 106 (1988).

rights include the rights to reproduce the work, to prepare derivative works, and to sell copies of the work to the public.⁶⁶ A copyright's term lasts for fifty years after the death of the sound recording artist.⁶⁷

A copyright owner's exclusive rights, however, are subject to certain limitations.⁶⁸ After the owner authorizes the public distribution of the copyrighted work any person that complies with the statutory requirements may obtain a license to "make and distribute phonorecords of the work."⁶⁹ Section 115 of the Copyright Act defines the scope and requirements of the compulsory license.⁷⁰ Once a licensee applies for and receives a license to use the copyrighted work, the licensee is entitled to re-create the song.⁷¹ The licensee, however, is neither allowed to reproduce the actual sound recording⁷² nor to change significantly the melody or character of the song.⁷³ The Act provides the copyright owner with compensa-

66. *Id.*; see also 17 U.S.C. § 114(b) (1988) (discussing scope of exclusive rights described in § 106).

67. 17 U.S.C. § 302(a) (1988).

68. See 17 U.S.C. § 115(a)-(c) (1988) (setting forth scope of compulsory license entitling other persons to use of copyrighted work); see also *Shapiro, Bernstein & Co. v. Remington Records, Inc.*, 265 F.2d 263, 270 (2d Cir. 1959) (stating that compulsory license is limitation for copyright owner and privilege for licensee).

69. See 17 U.S.C. § 115(a)(1) (1988). Section 115(a)(1) provides in pertinent part:

When phonorecords of a nondramatic musical work have been distributed to the public in the United States under the authority of the copyright owner, any other person may, by complying with the provisions of this section, obtain a compulsory license to make and distribute phonorecords of the work. A person may obtain a compulsory license only if his or her primary purpose in making phonorecords is to distribute them to the public for private use. A person may not obtain a compulsory license for use of the work in the making of phonorecords duplicating a sound recording fixed by another

Id.

70. 17 U.S.C. § 115 (1988).

71. See 17 U.S.C. § 115(a)(2) (1988) ("A compulsory license includes the privilege of making a musical arrangement of the work. . . .").

72. See *Jondora Music Publishing Co. v. Melody Recordings, Inc.*, 506 F.2d 392, 395 (3d Cir.) (stating that identical duplication of original work is not "similar use" as defined by compulsory license provisions), *cert. denied*, 421 U.S. 1012 (1975); *Edward B. Marks Music Corp. v. Colorado Magnetics, Inc.*, 497 F.2d 285, 288 (10th Cir. 1974) (deciding that duplicating and copying copyrighted work is not similar use); *Duchess Music Corp. v. Stern*, 458 F.2d 1305, 1310 (9th Cir.) (holding that exact copy of original work "is clearly outside the scope of the compulsory license scheme") (footnote omitted), *cert. denied sub nom. Rosner v. Duchess Music Corp.*, 409 U.S. 847 (1972).

73. See 17 U.S.C. § 115(a)(2) (1988) (stating that compulsory license is privilege, entitling licensee to make musical arrangement of copyrighted work without changing "basic melody or fundamental character" of work). The Act restricts the changes that a person may make to the original form of the work. *Id.* In fact, one court has held that the statute only authorizes "use of the copyrighted work, that is, the written score." *Jondora*, 506 F.2d at 395.

tion for the use of the work.⁷⁴ Thus, the licensee pays royalty fees to the copyright owner at royalty rate set by law.⁷⁵

In creating this compulsory licensing process, Congress attempted to strike a balance between two competing interests. On one hand, Congress wanted to encourage and reward composers for creative and artistic work; but on the other hand, it wanted to maintain public access to such works.⁷⁶ As a result, the Act both limits the copyright owner's right to withhold the song from the public and provides compensation to the copyright owner for the use of the song.⁷⁷

C. *Infringement*

Section 501(a) of the Copyright Act provides that "anyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright."⁷⁸ To show infringement of the copyright, a plaintiff must show proof of ownership of a valid copyright and demonstrate that the defendants copied the work.⁷⁹ To prove actual copying, which is difficult to do, a plaintiff must establish the following two elements: "(1) defendant's access to the copyrighted work prior to creation of defendant's work, and (2) substantial similarity of both general ideas and expression between the copyrighted work and the defendant's work."⁸⁰

74. See 17 U.S.C. § 115(c)(2) (1988) (stating that copyright owner shall be paid "either two and three-fourth cents, or one-half of one cent per minute of playing time . . . , whichever amount is larger" for each work copied); *id.* § 115(c)(4) (providing schedule for royalty payments, specifying that both monthly and annual statements are required); see also *Miller v. Goody*, 125 F. Supp. 348, 350-51 (S.D.N.Y. 1954) (holding that compulsory license on copyrighted work requires payment to owner for each record manufactured).

75. See *Recording Indus. Ass'n of Am. v. Copyright Royalty Tribunal*, 662 F.2d 1, 12-13 (D.C. Cir. 1981) (discussing fact that royalty rates are set by Copyright Royalty Tribunal, independent agency created by Congress and given power to determine rates).

76. See H.R. REP. NO. 2222, 60th Cong., 2d Sess. 7-8 (1909) (expressing fear that granting copyright to creators of musical compositions would encourage monopolization of such compositions).

77. *Jondora*, 506 F.2d at 395-96 (interpreting goal of compulsory licensing provision as that of preventing monopolies, not penalizing composer); *Shapiro, Bernstein & Co. v. Remington Records, Inc.*, 265 F.2d 263, 269 (2d Cir. 1959) (stating that intention of Copyright Act was to create reasonable compromise between protection of copyright owner from public exploitation of original work and avoidance of monopolization of musical compositions by owners).

78. 17 U.S.C. § 501(a) (1988).

79. *Atari, Inc. v. North Am. Phillips Consumer Elec. Corp.*, 672 F.2d 607, 614 (7th Cir.), *cert. denied*, 459 U.S. 880 (1982).

80. *Baxter v. MCA, Inc.*, 812 F.2d 421, 423 (9th Cir.), *cert. denied sub nom. Williams v. Baxter*, 484 U.S. 954 (1987).

1. *Ownership*

To prove copyright infringement, the owner of a sound recording must prove ownership.⁸¹ Under § 201 of the Act, the author of a particular work initially receives ownership of the copyright.⁸² In most cases, then, a copyright owner may prove ownership simply by showing authorship.⁸³ Under certain exceptional circumstances, however, the author of a work is not the owner of the copyright. For example, if the author were hired to create the work, then the copyright would rest not in the author, but in the employer for whom the work was made.⁸⁴ In this instance, the employer must demonstrate that the work was created for hire to establish rightful ownership.⁸⁵ Similarly, if the author previously conveyed all or part of the copyright to someone else, then the new owner has the burden of proving proper receipt of copyright ownership.⁸⁶

2. *Copying*

To prove infringement, the plaintiff in a copyright suit must prove that the defendant copied the sound recording by demonstrating that

81. The owner of a sound recording can prove ownership by producing proof of a copyright registration certificate. *See, e.g.,* Video Trip Corp. v. Lightning Video, Inc., 866 F.2d 50, 52 (2d Cir. 1989) (noting that plaintiff must prove valid ownership of copyright); *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1163 n.5 (9th Cir. 1977) (stating that proof of ownership is minimal burden on plaintiff because prerequisites for copyright registration are not complicated); *Universal Athletic Sales Co. v. Salkeld*, 340 F. Supp. 899, 900-01 (W.D. Pa. 1972) (holding that plaintiff met prima facie evidence of copyright ownership by producing copyright registration number and publication date).

82. 17 U.S.C. § 201(a) (1988) (stating that title is first vested in author(s) of work).

83. *See Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951) (stating that author must simply prove that her work is original composition, owing its origin to author).

84. 17 U.S.C. § 201(b) (1988) (stating that in work made for hire, employer has title unless written agreement states otherwise).

85. The work must be made within the scope of employment for an employer to be considered the owner of a copyright. *See, e.g.,* *Murray v. Gelderman*, 566 F.2d 1307, 1309-10 (5th Cir. 1978) (ruling that author who created menu book project while working for corporation owned copyright instead of employer because work was not created within scope of employment); *Reporters Comm. for Freedom of Press v. Vance*, 442 F. Supp. 383, 386-87 (D.D.C. 1977) (declaring that work created by employee of United States within scope of employment belongs to U.S. Government), *aff'd*, 589 F.2d 1116 (D.C. Cir. 1978), *aff'd in part, rev'd in part sub nom. Kissinger v. Reporters Comm. for Freedom of Press*, 445 U.S. 136 (1980); *Siegel v. National Periodical Publications, Inc.*, 508 F.2d 909, 914 (2d Cir. 1974) (holding that comic strip was not within scope of employment because authors of strip created main character long before employment relationship with publisher).

86. *See* 17 U.S.C. § 201(d)(1) (1988) (providing that "[t]he ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession"); *id.* § 201(d)(2) (stating that new copyright owner is entitled to same protection and remedies as original owner).

the defendant had "access" to the recording and that the two works are substantially similar.⁸⁷

a. Access

Without proof of access, the similarity between two works may be purely coincidental.⁸⁸ Courts generally agree that the test for access is whether the defendant had a reasonable opportunity to view the copyrighted work.⁸⁹ In sampling cases, access is rarely an issue because, by definition, sampling involves the purposeful usurpation of, and thus access to, another's work.⁹⁰

b. Substantial similarity

Unlike the access determination, the question of substantial similarity is an important issue in most sampling cases.⁹¹ The test for substantial similarity is whether a reasonable person would recognize

87. See, e.g., *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982) (discussing that to prove copying plaintiff must show "circumstantial evidence of access to the protected work and . . . substantial similarity of 'ideas' and 'expression' between the copyrighted work and the allegedly infringing work"); *Atari, Inc. v. North Am. Philips Consumer Elec. Corp.*, 672 F.2d 607, 614-21 (7th Cir.) (holding that copying can be inferred by proving access and substantial similarity), *cert. denied*, 459 U.S. 880 (1982); *Herwitz v. NBC*, 210 F. Supp. 231, 234-35 (S.D.N.Y. 1962) (stating that copying is shown by "establishing access and similarity").

88. See *Goldman-Morgen, Inc. v. Dan Brechner & Co.*, 411 F. Supp. 382, 389 (S.D.N.Y. 1976) (stating that access, or inference of access, is shown when defendant's work is virtually identical to plaintiff's copyrighted work and attributing such similarity to infringement, not coincidence); *Stratchborneo v. Arc Music Corp.*, 357 F. Supp. 1393, 1403 (S.D.N.Y. 1973) (holding that similarities in two works constitute "copying rather than coincidence"); *Universal Athletic Sales Co. v. Salkeld*, 340 F. Supp. 899, 901 (W.D. Pa. 1972) (observing that without access requirement in infringement cases, defendants could contend that similarity between two works is merely coincidental).

89. See, e.g., *Koontz v. Jaffarian*, 787 F.2d 906, 910 (4th Cir. 1986) (concluding that working relationship between plaintiff and defendant provided defendant with sufficient access to plaintiff's work for purposes of proving infringement); *Miller Brewing Co. v. Carling O'Keefe Breweries of Can., Ltd.*, 452 F. Supp. 429, 438 (W.D.N.Y. 1978) (stating test for access as whether defendant had reasonable opportunity to see or copy protected work); *Universal Athletic Sales*, 340 F. Supp. at 901 (holding that test for access was satisfied because defendant had "reasonable opportunity" to view original work). At issue in this case were wall charts and sketches for gymnasium exercising equipment. *Id.* at 900. One defendant admitted in deposition testimony that he had seen the charts and sketches, that someone had sent him some sketches, and that he had given the sketches to his artist. *Id.* at 901.

90. See Note, *supra* note 26, at 733 n.30 (arguing that access element usually is fulfilled in sampling cases).

91. Note, *supra* note 26, at 733-34. The substantial similarity issue becomes contentious because samplers argue that although they need to use a recognizable portion, the use is de minimus and thus not an infringement. *Id.* Courts, however, have consistently held that even if the use is small, it constitutes infringement if it is "qualitatively important." See, e.g., *Baxter v. MCA, Inc.*, 812 F.2d 421, 425 (9th Cir.) (holding that infringement is found if use is qualitatively important, despite amount of material copied), *cert. denied sub nom. Williams v. Baxter*, 484 U.S. 954 (1987); *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 361 (9th Cir. 1947) (stating that copying of major sequence is enough to constitute infringement), *disapproved on other grounds by F.W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228 (1952).

that the defendant took the copyrighted work and incorporated it into a new work.⁹² A general impression of similarity is not sufficient to constitute "substantial" similarity.⁹³ Rather, the "total concept" and "feel" of the two works must be similar.⁹⁴ At the same time, however, a copyright owner does not have to show that every small detail of the protected work was duplicated.⁹⁵ In fact, the duplication of only a small part of the work may be considered substantial if the part taken was an important and material part of the work.⁹⁶

3. *The defense of fair use*

In determining whether an act constitutes infringement, courts recognize that certain acts, such as fair use, are defensible. Specifically, § 107 provides an affirmative defense to potential infringers of the fair use doctrine.⁹⁷ Section 107 does not define "fair use," but merely lists four factors for courts to weigh in determining whether the use of a copyrighted work is fair.⁹⁸ The Act is silent, however, as

92. See *Litchfield v. Spielberg*, 736 F.2d 1352, 1355-56 (9th Cir. 1984) (holding that substantial similarity exists if "reasonable minds could not differ" when considering likeness between musical play "Lokey From Maldemar" and motion picture "E.T."), *cert. denied*, 470 U.S. 1052 (1985); See *v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983) (concluding that district court properly granted summary judgment in copyright infringement claim where no reasonable juror could find substantial similarity between two plays).

93. See *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 912 (2d Cir. 1980) (recognizing that although toys made by two different toy companies were similar in certain aspects, more than "general impression of similarity" is needed to demonstrate infringement).

94. *Litchfield*, 736 F.2d at 1357. In *Warner Bros. v. ABC*, 530 F. Supp. 1187 (S.D.N.Y. 1982), *aff'd*, 720 F.2d 231 (2d Cir. 1983), owners of movies, comic books, and television shows featuring "Superman" sued the creators of the television show "The Greatest American Hero" for copyright infringement. *Id.* at 1189. The plaintiffs claimed that the Greatest American Hero had attributes similar to Superman, including super-hearing, super-vision, super-breath, super-speed, and invulnerability. *Id.* at 1190-91. Additionally, both characters had an alter ego and encounters with alien beings. *Id.* at 1191. Despite these similarities, the court ruled that the "total concept and feel" of the heroes differed. *Id.* at 1195. Unlike Superman, the Greatest American Hero was somewhat vulnerable. *Id.* at 1194-95. He was insecure about his superpowers and quietly struggled with his new responsibilities. *Id.* In fact, it was this vulnerability that often made the show comical, as opposed to the general seriousness of "Superman." The advertisements for "The Greatest American Hero," for example, said "He may be unable to leap tall buildings in a single bound, he may be slower than a speeding bullet, and he may be less powerful than a locomotive . . . [but] he's just getting started." *Id.*

95. See *Baxter*, 812 F.2d at 425 (noting that "no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity"), *cert. denied sub nom. Williams v. Baxter*, 484 U.S. 954 (1987).

96. See *Associated Music Publishers, Inc. v. Debs Memorial Radio Fund*, 141 F.2d 852, 855 (2d Cir.) (ruling that use of one-quarter of musical composition constituted copyright infringement), *cert. denied*, 323 U.S. 766 (1944); *Miller Brewing Co. v. Carling O'Keefe Breweries of Can., Ltd.*, 452 F. Supp. 429, 439-40 (W.D.N.Y. 1978) (holding that use of small portion of television commercial may constitute infringement if portion were material and significant).

97. 17 U.S.C. § 107 (1988) (establishing guidelines for copying from protected works to ensure that copying is fair).

98. *Id.* Section 107 provides, in pertinent part, that a court shall consider:

to how much weight courts should allocate to each factor.⁹⁹ The Supreme Court has also provided little guidance, explaining only that "[s]ection 107 requires a case-by-case determination whether a particular use is fair."¹⁰⁰

The first factor listed in § 107 is the purpose and character of the use.¹⁰¹ If the work is used for nonprofit educational purposes, for example, fair use may be presumed.¹⁰² A work used for commercial purposes, however, would not constitute a fair use.¹⁰³ The second consideration is the nature of the copyrighted work.¹⁰⁴ Courts generally permit the use of a longer portion of a protected work if the work is an informational collection of facts as opposed to a creative piece.¹⁰⁵ The third factor is the amount and substantiality of the portion used.¹⁰⁶ When determining whether this element has been met, courts look to the same considerations set forth in the substantial similarity element of infringement;¹⁰⁷ specifically, courts

-
- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
 - (2) the nature of the copyrighted work;
 - (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
 - (4) the effect of the use upon the potential market for or value of the copyrighted work.

Id.

99. See *id.* (listing four factors that constitute fair use doctrine, but not providing guidance on how to implement those factors). The language of § 107 is particularly vague. For example, the four factors to be considered are preceded by the words "shall include." *Id.* Courts have struggled with the meaning of fair use because the statute does not provide a bright line rule. See *New Era Publications Int'l v. Carol Publication Group*, 904 F.2d 152, 155 (2d Cir.) (discussing recent articles that offer suggestions for clarification of fair use doctrine), *stay denied*, 497 U.S. 1054, and *cert. denied*, 498 U.S. 921 (1990).

100. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549 (1985).

101. 17 U.S.C. § 107 (1988).

102. *Id.* (stating in preamble that fair use of copyrighted work includes teaching, scholarship, or research). Using a work for educational purposes, however, does not necessarily mean that the use is fair. See *Marcus v. Rowley*, 695 F.2d 1171, 1175 (9th Cir. 1983) (arguing that teacher's use of booklet on cake decorating for home economics class did not automatically require finding of fair use).

103. Cf. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 419-21, 449 (1984) (holding that video cassette recorders used to make copies for commercial or profitable use would tend to suggest unfair use).

104. 17 U.S.C. § 107 (1988).

105. See *Dow Jones & Co. v. Board of Trade*, 546 F. Supp. 113, 120 (S.D.N.Y. 1982) (holding that stock market indices, which are factual compilations, are not creative in nature and may be distributed without violating copyright).

106. 17 U.S.C. § 107 (1988).

107. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 564-65 (1985) (ruling that although portion of President Ford's book published by defendant was small, portion was qualitatively important and suggested unfair use); see also *supra* notes 91-96 and accompanying text (discussing standards for deciding substantial similarity).

consider both quantitative and qualitative similarity.¹⁰⁸ If a court finds substantial similarity, it generally will find that the use was not fair.¹⁰⁹ The fourth and final factor is the effect of the use on the potential market for the copyrighted work.¹¹⁰ A use that produces a negative effect on the sales market for the original work will tend to deny a finding of fair use.¹¹¹

D. Remedies

Section 504 of the Copyright Act provides damage awards for the copyright owner once infringement has been proven.¹¹² The Act states that the infringer is liable for either actual damages and profits¹¹³ or statutory damages.¹¹⁴ Actual damages generally are

108. See *Consumers Union of United States v. General Signal Corp.*, 724 F.2d 1044, 1050 (2d Cir. 1983) (holding that defendant's use of 29 words from article of 2100 words was insubstantial, and therefore fair use), *cert. denied*, 469 U.S. 823 (1984); *Roy Expert Co. Establishment v. CBS*, 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980) (stating that use of film excerpts, though quantitatively small, was qualitatively substantial and goes against finding of fair use), *aff'd*, 672 F.2d 1095 (2d Cir. 1982). At issue in *Roy Expert* were excerpts of Charlie Chaplin films owned by CBS. CBS argued that the scenes "were among Chaplin's best . . . and [were] central to the film in which [they] appeared." *Roy Expert*, 503 F. Supp. at 1145. The trial judge conjectured that "there would be substantial taking of 'Gone With the Wind' if somebody just took the burning of Atlanta . . . ten or fifteen minutes of a three or four hour movie." *Id.*

109. See *supra* note 108 (presenting cases in which courts found against fair use because two works were substantially similar).

110. 17 U.S.C. § 107 (1988).

111. See *Iowa State Univ. Research Found. v. ABC*, 621 F.2d 57, 62 (2d Cir. 1980) (holding that television network's use of plaintiffs' student-produced film biography was not fair use because network's use significantly reduced potential market for sale of plaintiffs' film).

112. See 17 U.S.C. § 504(a) (1988) (stating that copyright infringer is liable for either actual damages and profits or statutory damages).

113. *Id.* § 504(b) ("The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages."); see also *F.W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228, 233 (1952) (stating that cumulative damage award supports intent of law to compensate copyright owner and discourage unlawful infringer); *Miller v. Universal Studios, Inc.*, 650 F.2d 1365, 1375 (5th Cir. 1981) (holding that plaintiff is entitled to both "damages sustained by him and profits earned by the infringers"); cf. *Taylor v. Meirick*, 712 F.2d 1112, 1120 (7th Cir. 1983) (warning that amount of infringer's profits, if much greater than actual damages, could constitute windfall for copyright owner).

114. 17 U.S.C. § 502(a) (1988) ("[T]he copyright owner may elect, at any time before final judgment is rendered, to recover, *instead of* actual damages and profits, an award of statutory damages . . . in a sum of not less than \$500 or more than \$20,000 as the court considers just.") (emphasis added). If a plaintiff elects to recover statutory damages, he or she is not required to submit proof of damages or profits, but instead is awarded between \$500 and \$20,000 at the court's discretion. 3 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 14.01[B], at 14-7 n.15 (1993); see *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1177-78 (9th Cir. 1977) (holding that award of statutory damages is within discretion of court). In determining statutory award, the court must consider "the nature of the copyright, the circumstances of the infringement, and the like." *Sid & Marty Krofft*, 562 F.2d at 1177-78 (quoting *Westermann Co. v. Dispatch Printing Co.*, 249 U.S. 100, 106 (1919)).

measured by the market value of profits lost by the copyright owner.¹¹⁵ Infringer's profits, which the owner is entitled to, are determined by deducting certain costs from the infringer's gross revenue.¹¹⁶ Statutory damages are available even without evidence that the plaintiff has suffered actual damages.¹¹⁷ The court has wide discretion in determining the amount of damages as long as it remains within the statutory limits.¹¹⁸

In addition, injunctive relief is available to copyright owners to "prevent or restrain infringement" of their copyrighted work.¹¹⁹ Some courts apply the traditional four-factor test to determine the appropriateness of injunctive relief.¹²⁰ Other courts focus their inquiry on two of the four factors: the likelihood of success on the merits and the threat of irreparable injury.¹²¹ Arguably, this test

115. 17 U.S.C. § 504(b) (1988).

116. *Id.*

117. *Blackmun v. Hustler Magazine, Inc.*, 800 F.2d 1160, 1163 (D.C. Cir. 1986); *Harris v. Emus Records Corp.*, 734 F.2d 1329, 1335 (9th Cir. 1984) (citing 3 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 14.04[A] (1983)); *Bourne Co. v. Speeks*, 670 F. Supp. 777, 780 (E.D. Tenn. 1987).

118. 17 U.S.C. § 504(c) (1988). Section 504(c)(1) provides that the trial court may award between \$500 and \$20,000 for a single infringement. *Id.* § 504(c)(1). If the court finds that the infringement is willful, however, it may increase the award to up to \$100,000. *Id.* § 504(c)(2). Conversely, if the court finds that the defendant was ignorant and had no reason to believe she was infringing, the court may reduce the award to \$200. *Id.* The court has the discretion to set the damages award anywhere within these limits and will only be overturned if it abuses its discretion. See *Russell v. Price*, 612 F.2d 1123, 1131-32 (9th Cir. 1979) (finding that court did not abuse discretion in awarding statutory amount), *cert. denied sub nom. Drebin v. Russell*, 446 U.S. 952 (1980); *Halnat Publishing Co. v. L.A.P.A., Inc.*, 669 F. Supp. 933, 937 (D. Minn. 1987) (finding that court has discretion in deciding damages as long as amount falls within statutory limits); *Rare Blue Music, Inc. v. Guttadauro*, 616 F. Supp. 1528, 1531 (D. Mass. 1985) (explaining that determining amount of statutory damages lies within "sound discretion of the court").

119. See 17 U.S.C. § 502(a) (1988) ("Any court having jurisdiction of a civil action arising under this title may . . . grant temporary and final injunctions as it may deem reasonable to prevent or restrain infringement of a copyright.").

120. See, e.g., *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 613 (7th Cir.) (stating four factors court considers in granting or denying preliminary injunction), *cert. denied*, 459 U.S. 880 (1982); *West Publishing Co. v. Mead Data Central, Inc.*, 616 F. Supp. 1571, 1575 (D. Minn. 1985) (discussing factors courts should consider before granting injunctive relief), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987). The court in *Atari* enumerated the following four factors:

- (1) whether the plaintiff will have an adequate remedy at law or will be irreparably harmed if the injunction does not issue;
- (2) whether the threatened injury to the plaintiff outweighs the threatened harm the injunction may inflict on the defendant;
- (3) whether the plaintiff has at least a reasonable likelihood of success on the merits; and
- (4) whether the granting of a preliminary injunction will disserve the public interest.

Atari, 672 F.2d at 613.

121. See, e.g., *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1174 (9th Cir. 1989) (holding that showing of success on merits raises presumption of irreparable harm, and thus plaintiff need only show likelihood of success on merits to support granting of injunction); *Dumas v. Gommerman*, 865 F.2d 1093, 1095 (9th Cir. 1989) (stating that district

can be reduced to the likelihood of success on the merits.¹²²

Finally, if the court finds that the infringement is willful, the court can impose criminal sanctions.¹²³ Courts are split, however, on the question of what level of intent constitutes willfulness. Some courts hold that only a general intent to act constitutes willfulness, even if the defendant did not realize that he or she was acting in an illegal manner; other courts require a specific intent to break the law.¹²⁴

III. THE CONTROVERSY SURROUNDING DIGITAL SAMPLING

A. *The Debate Over Substantial Similarity*

The legality of unauthorized digital sampling has divided the music industry. One issue that has caused much debate is the role of "substantial similarity" in a digital sampling suit.¹²⁵ The controversy arises over the use of the word "actual" in § 114(b)¹²⁶ of the

court properly considered likelihood of success on merits and possibility of irreparable harm in granting preliminary injunction); *Apple Computer, Inc. v. Formula Int'l Inc.*, 725 F.2d 521, 521-26 (9th Cir. 1984) (awarding preliminary injunction because court found likelihood of success on merits and threat of irreparable harm); *Universal City Studios, Inc. v. Film Venture Int'l, Inc.*, 543 F. Supp. 1134, 1139 (C.D. Cal. 1982) (ruling that plaintiff must demonstrate irreparable injury and likelihood of success on merits in order to receive injunctive relief); *Stern Elecs., Inc. v. Kaufman*, 523 F. Supp. 635, 638 (E.D.N.Y. 1981) (granting video game distributor preliminary injunction based on showing of irreparable harm and probability of success on merits), *aff'd*, 669 F.2d 852 (2d Cir. 1982).

122. See NIMMER, *supra* note 114, § 14.06[A], at 14-87 n.30 (discussing that test can basically be reduced to showing likelihood of success on merits because prima facie case of infringement presumes irreparable harm).

123. 17 U.S.C. § 506(a) (1988).

124. Compare *United States v. Backer*, 134 F.2d 533, 535 (2d Cir. 1943) (finding willful infringement where there was overwhelming evidence that defendant had intent to make copies for profit) and *United States v. Taxe*, 380 F. Supp. 1010, 1010-18 (C.D. Cal. 1974) (finding willful infringement without express finding that defendant knowingly violated law), *aff'd in part, vacated in part*, 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977) with *United States v. Wise*, 550 F.2d 1180, 1194-95 (9th Cir.) (finding willfulness only because appellant knew that films that he sold had not been previously sold by copyright owner), *cert. denied*, 434 U.S. 929 (1977) and *United States v. Rose*, 149 U.S.P.Q. 820, 824 (S.D.N.Y. 1966) (requiring specific intent for willful infringement of copyright).

125. It is well settled, as a general rule of copyright law, that a plaintiff must show substantial similarity between the two works in order to prove infringement. See *supra* note 80 and accompanying text (stating that substantial similarity is element of case for infringement). What is not settled, however, is how the concept of substantial similarity applies to digital sampling. See McGraw, *supra* note 4, at 161-62 (discussing how much similarity may be needed for digital sampling to constitute infringement); Houle, *supra* note 32, at 891-92 (showing conflict between desire of courts not to enjoin work simply because it uses small portion of another song and public policy that plagiarism never should be excused, no matter how small the infringement); Note, *supra* note 26, at 734 (providing different ways to judge substantial similarity).

126. Section 114(b) provides in pertinent part:

The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords, or of copies of motion pictures and other audiovisual works, that directly or indirectly recapture the actual sounds fixed in the recording.

17 U.S.C. § 114(b) (1988) (emphasis added).

Copyright Act.¹²⁷ On one hand, this term can be viewed as prohibiting the usurpation of any exact sound from a song.¹²⁸ But on the other hand, a plaintiff in a copyright suit must demonstrate substantial similarity between the two works in order to prove infringement.¹²⁹ This substantial similarity requirement thus suggests that the Copyright Act might allow some actual use of a copyrighted song without that use rising to the level of infringement.

Sampling advocates focus on the substantial similarity requirement. They suggest that while § 114(b) does protect actual sounds, samplers' technological capability to alter sounds¹³⁰ changes sampled sounds to such a degree that a sampler can change them to completely new sounds.¹³¹ Sampling advocates argue that despite the fact that samplers use the actual sounds, most sampled recordings do not contain enough similarity to constitute infringement.¹³²

In response, some sampling critics have argued that the question of substantial similarity does not apply to digital sampling nor to whether a sampler's work constitutes infringement.¹³³ Instead, they argue that the test to determine infringement should consider whether

127. 17 U.S.C. §§ 101-810 (1988).

128. See, e.g., Marcus, *supra* note 7, at 776 (discussing argument that inclusion of word "actual" in § 114(b) explicitly prohibits use of exact sounds from copyrighted work); McGiverin, *supra* note 32, at 1731-32 (concluding that digital sampling is taking of actual sounds under § 114); Wells, *supra* note 32, at 701 (implying that appropriation of actual sounds constitutes infringement regardless of how sampler uses them).

129. See *supra* notes 91-96 and accompanying text (discussing test of substantial similarity in infringement cases).

130. See *supra* note 36 (describing myriad ways sampler can alter or manipulate sounds).

131. See Bynam, *supra* note 35, at 375-76 (stating that samples often are altered before use); Dupler, *supra* note 13, at 74 ("In defense of sampling, it should be pointed out that with the exception of a very few units, most samplers do not re-create exact sonic pictures of what is sampled. . . . You usually use the sample as a base sound and then process it, filter it, play with it, to make it sound better.") (quoting Bobby Nathan, co-owner of Unique Records).

132. See Sherri C. Hampel, Comment, *Are Samplers Getting a Bum Rap?: Copyright Infringement or Technological Creativity?*, 1992 U. ILL. L. REV. 559, 573-74 (arguing that digital sampling devices are musical instruments that create unique musical sounds or interpretations that simulate, but are distinct from, actual sounds). If accepted as true, Hampel's argument satisfies § 114(b), which provides that there is no copyright protection for "the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording." 17 U.S.C. § 114(b) (1988) (emphasis added). Hampel argues that a digital sampler is a distinct musical instrument because it receives sounds, converts them to digital bits, and re-creates them in some altered form. See Hampel, *supra*, at 572-73. Thus, she argues that, technically, the sampling process does not use actual sounds, but rather digitally interpreted sounds, creating an "independent fixation" of the sounds. *Id.* Under this interpretation, digital sampling is no more illegal under § 114(b) than a guitarist playing a previously recorded song. *Id.* at 573-74.

133. See Thom, *supra* note 15, at 326 (presenting argument that substantial similarity test is inapplicable to sound recordings); cf. *United States v. Taxe*, 380 F. Supp. 1010, 1014 (C.D. Cal. 1974) (finding that substantial similarity test is irrelevant in infringement determination).

someone has used the exact sounds of a copyrighted song.¹³⁴ Thus, if an individual has used the actual sounds of a copyrighted song, that person should be found liable for infringement, regardless of how much he or she altered the original sound.¹³⁵

This debate typically involves a discussion of *United States v. Taxe*.¹³⁶ In that case, the owners of sound recordings claimed that the defendants violated copyright law when they sold "pirated" copies of the plaintiff's songs.¹³⁷ The court upheld the claim, ruling that even though the defendants had altered the songs before selling them, they still had illicitly duplicated the work.¹³⁸

Each side in the sampling debate interprets *Taxe* differently. Sampling opponents claim that the test for infringement turns on only one question: whether the actual sounds were used.¹³⁹ Sampling proponents, on the other hand, point out that while the court of appeals upheld the district court's judgment in granting the plaintiff's claim, it also ruled that the lower court's per se rule—that all use of actual sounds constitutes infringement—was erroneous.¹⁴⁰

134. See Thom, *supra* note 15, at 326 (suggesting that substantial similarity test does not apply to sampling by virtue of fact that Copyright Act forbids use of actual sound recordings). But see Wells, *supra* note 32, at 701 (arguing that traditional test for infringement—ownership, copying, and illicit copying—must be applied in cases of digital sampling).

135. Wells, *supra* note 32, at 701.

136. 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977).

137. *United States v. Taxe*, 540 F.2d 961, 964 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977). Richard Taxe was one of four defendants who directed an operation that purchased records from retail outlets and later resold them. *Id.* at 964. The defendants would obtain stereo eight-track tape recordings manufactured by major record companies and then re-record the records with special equipment that would allow them to alter the originals by changing the speed of the recording, adding reverberation and other synthesizer sounds, and eliminating or reducing in volume some of the sounds from the songs. *Id.* Once the songs were ready to sell, the defendants would promote them through national advertising, claiming that they were authentic. *Id.*

138. See *id.* at 966 (using lower court's reasoning to find infringement because of unauthorized duplication despite any alteration in sound). The lower court held that the changes made in the sound recording were inaudible "to the human ear and were intended to be so." *United States v. Taxe*, 380 F. Supp. 1010, 1013 (C.D. Cal. 1974), *aff'd in part, vacated in part*, 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977). Consequently, the court held that the alterations had minimal effect on the question of infringement. *Id.* at 1014-15. Furthermore, the trial court held that the alterations had no bearing on the case because the only relevant question was whether the use of the work was an appropriation of the actual sounds or a mere imitation. *Id.* at 1014 (ruling that "substantial similarity" has no relevance to question of infringement).

139. See Note, *supra* note 26, at 736 (explaining that *Taxe* suggests that unauthorized sampling would be actionable despite alterations of original song).

140. *Taxe*, 540 F.2d at 965. The lower court expressed its per se rule in a jury instruction that told the jurors to consider only whether the defendant used actual sounds. See *Taxe*, 380 F. Supp. at 1014-15 (discussing jury instructions that asked jury to consider whether defendants' works were re-recording or new and independent fixation). The court of appeals later said, "We believe the instruction went beyond the law insofar as it purported to characterize any and all re-recordings as infringements . . ." *Taxe*, 540 F.2d at 965. The court of appeals did not reverse the judgment, however, because the rest of the instruction did allow the jury to consider

Supporters argue that the higher court's denunciation of this rule suggests that the use of actual sounds may be legal if the use is not significant.¹⁴¹ As a result, some sampling proponents interpret *Taxe* as implying that the Copyright Act permits digital sampling if the use is not substantial.¹⁴²

If this interpretation of *Taxe* is correct, the next logical step is to define "substantial." Advocates of sampling argue that sampling often uses such a small, insubstantial amount of actual sounds from another work that most sampled songs are protected by the fair use doctrine.¹⁴³ Some supporters of sampling thus call for a quantitative approach to whether a use is fair, arguing that substantiality is determined by the amount of material that is taken from another song.¹⁴⁴

Others in the industry disagree, arguing that a qualitative approach is more important for the purpose of deciding substantiality.¹⁴⁵ A qualitative approach is less concrete. It forsakes numbers and amounts for the abstract importance that the particular musical phrases have on how listeners remember and associate songs. Under this test, even the use of a quantitatively small portion of a song can be an unfair use if that portion is materially important to the song.¹⁴⁶ For example, under a qualitative approach, use of only one

the substantial similarity question, thereby curing the error in the earlier part of the instruction. *Id.*

141. See Marcus, *supra* note 7, at 777 n.63 (reporting entertainment lawyer Ken Anderson's view that *Taxe* stands for proposition that literal copying is not automatically infringement because some smaller portions will be considered de minimis). Mr. Anderson argues that, under *Taxe*, copying "must be substantially similar to the original recording as a whole" to be regarded as infringement. *Id.*

142. See Marcus, *supra* note 7, at 777 n.62 (noting that *Taxe* court expressed view that trivial re-recording is too insubstantial to constitute infringement).

143. See *supra* notes 107-08 and accompanying text (discussing premise that use of only small portion of song may not constitute infringement under fair use doctrine). For example, rap artists often use only small parts of sampled material in small parts of their songs. See Sanjek, *supra* note 22, at 613 (stating that "[m]ost often the amount of sampling, particularly on rap recordings, is minimal, the emphasis being laid on the rap itself and the beat supporting it; excessive sampling might be felt to intrude upon the vocal performance").

144. This argument relies on the Act's specific use of the word "amount" in factoring whether something is a fair use. See 17 U.S.C. § 107 (1988) (providing that "amount and substantiality of the portion used" is third factor in deciding fair use).

145. See Note, *supra* note 26, at 734 (stating that "it seems logical to conclude that even a short sample of a musical composition might be an infringing use if the sample was recognizable by comparing the two works and was 'important' to its source."); Marsha A. Willis, Comment, *Unauthorized Digital Sound Sampling, The Taking Of a Constitutional Right*, 17 S.U. L. REV. 309, 317 (1990) (arguing that "qualitative approach should be taken in analyzing the sampling").

146. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565-66 n.8 (1985) (ruling that, although defendant took only 300 words out of former President Ford's book, there was no fair use because portion played important role in defendant's publication, thus constituting qualitatively important excerpt); *Meeropol v. Nizer*, 417 F. Supp. 1201, 1209-13 (S.D.N.Y. 1976) (deciding whether use of quantitatively small portion of book was qualitatively

measure of a song would satisfy the substantial similarity test if that measure were a signature phrase, one of the best known and recognizable parts of the song. This approach, while perhaps less concrete and less workable than the quantitative test, may produce a more accurate comparative analysis by returning the inquiry to the essence of the music.¹⁴⁷

Finally, people on both sides of the argument debate whether a song that employs digital sampling is so recognizably similar to the original song as to constitute infringement.¹⁴⁸ Samplers argue that they often alter the sampled sounds to such a degree that a reasonable listener likely would not recognize that one song borrowed from the other.¹⁴⁹ Samplers also defend sampling by arguing that the art form inherently requires uniquely recognizable sounds derived from other works.¹⁵⁰ Yet, when samplers admit that they use recognizably

important for purposes of deciding fair use), *aff'd in part, rev'd in part*, 560 F.2d 1061 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

147. The quantitative versus qualitative debate has also divided the courts. Compare *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir.) (rejecting quantitative approach by holding that "[n]o plagiarist can excuse the wrong by showing how much of his work he did not pirate"), *cert. denied*, 298 U.S. 669 (1936) with *Brodsky v. Universal Pictures Co.*, 149 F.2d 600, 600-01 (2d Cir. 1945) (rejecting plaintiff's copyright infringement claim because extent of similarity between plaintiff's song and defendant's song was only few measures) and *Carew v. R.K.O. Radio Pictures, Inc.*, 43 F. Supp. 199, 201 (S.D. Cal. 1942) (ruling against plaintiff because parts of copyrighted song defendant used were too short in length to constitute infringement) and *Davilla v. Harms*, 36 F. Supp. 843, 844 (S.D.N.Y. 1940) (holding that "slight resemblance in the progression of a few bars in both compositions . . . is not enough to make out a case of piracy").

148. See, e.g., *Houle*, *supra* note 32, at 893 (noting that some argue that only four recognizable measures constitute infringement); *McGiverin*, *supra* note 32, at 1735 (questioning "whether a taking of no more than a few notes is de minimus"); *Thom*, *supra* note 15, at 328-29 (presenting controversy over whether law should use entire song as reference point for recognizability test or whether it should examine song component by component, looking individually at each instrument and vocalist).

149. See *supra* notes 130-31 and accompanying text (discussing argument that samplers drastically change original sampled sounds).

150. See *Considine*, *supra* note 1, at 107 ("[W]hat makes sampling so attractive isn't that it's easier to pinch a James Brown scream than to learn how to make that sound yourself. Rather, it's the fact that there's something immediately recognizable about that scream, that it carries a specific association: Soul Brother No. 1."); *Dupler*, *supra* note 13, at 74 (explaining that producer/remixer used drummer John Bonham's kick drum from Led Zeppelin's "Houses of the Holy" in latest album because of its uniqueness); *Rule*, *supra* note 7, at C18 (repeating industry attorney's belief that rap music, in order to be pure and true to its genre, requires use of earlier works, and "business concerns" should not interfere with this); *Songwriter Wins Large Settlement in Rap Suit*, L.A. TIMES, Jan. 1, 1992, at F1 (reporting comment of record company executive, Dan Charnas, that "it's difficult to apply conventional pop copyright laws to rap because there is artistry in taking the electronic samples").

Sampling critics, however, may challenge the argument that sampling is an art form that inherently relies on other people's works. As proof that sampling does not need to use previous songs, critics might point to evidence that many rappers are abandoning sampling and are now using their own musicians in their songs. See *Leland*, *supra* note 7, at 55 (quoting popular rapper/sampler Prince Paul as stating, "I [now] have a trumpet player, a guitar player, a bass. No samples"); *Rule*, *supra* note 7, at C18 (noting that rapper L.L. Cool J recently toured with

unique portions of songs, they refute their own argument that sampling often fails to meet the substantial similarity test.

B. *The Debate Over Originality*

Proponents of sampling often argue that sampling is no different from other art forms that rely on older works, and should thus be accorded the favorable legal treatment that these other art forms presently receive.¹⁵¹ They do not understand why samplers are penalized when other artists also borrow from earlier works of art

his own band rather than use samples and that Hammer's most recent album, "Too Legit to Quit" does not contain samples). If rap music's creativity continues to flourish without the use of sampling, then it is possible that sampling never was an original art form, but rather was only an excuse to cut music production costs. *But see* Rule, *supra* note 7, at C18 (presenting Ken Anderson's hope that increased use of musicians in rap music has resulted from natural evolution of music and not for legal reasons).

151. *See* Rule, *supra* note 7, at C13, C18 (quoting entertainment lawyer Ken Anderson who argues that other forms of art traditionally have relied on previous material and yet are considered original by general public). Anderson states: "A comedian parodying something pre-existing—a book, a movie or someone's life—has got to make a reference to it for the parody to work. If copyright law prevented that, it would be destroying a form of creative art and that would not be in keeping with the purpose of the copyright law. The same principle applies to the way certain rap composers intentionally refer to prior recordings." *Id.* at C18.

Some authors also suggest that the originality of digital sampling may be viewed in much the same way as the originality in modern visual art. Marcus, *supra* note 7, at 772. Like Andy Warhol's paintings of Campbell's soup cans in the 1960s, digital sampling involves the reinterpretation of earlier works in a new context. *Id.* This concept of art "forces the viewer or listener to question and rethink commercial presentation and materialism in society." *Id.* In fact, even before the pop art era, the cubist movement of the early twentieth century gave rise to the collage, which pieced together fragments of actual objects into one single work of art. ADELHEID M. GEALT, *LOOKING AT ART: A VISITOR'S GUIDE TO MUSEUM COLLECTIONS* 436 (1983). Similarly, the surrealism movement of 1924-1940 relied on techniques that put recognizable objects into new contexts to give them new meaning. *Id.* at 443.

Gealt argues that digital sampling is similar to these forms of art because it takes pieces of previous works and recombines them to create a new work. *Id.* Dan Charnas, director of promotion at Def American Records, believes that there is art in taking samples of earlier works and putting them into new settings. Chuck Phillips, *Songwriter Wins Large Settlement in Rap Suit*, L.A. TIMES, Jan. 1, 1992, at F1, F2. Phillips laments the fact that the U.S. legal system does not seem to have the capacity to see such art. *Id.*

Some suggest that the heavy criticism rap music and sampling receive stems from racial prejudice. David Browne, *No Free Samples?*, ENTERTAINMENT WEEKLY, Jan. 24, 1992, at 54, 56; Ressler, *supra* note 4, at 105 (noting that some observers, such as sound engineer Bilal Bashir, argue that people seize upon "any little loophole" to criticize rap and sampling because "[r]ap is black art"). Others believe that the public associates rap with the gang violence it sees on the television news and thus feels threatened by rap. Robert Hilburn, *Getting a Bad Rap*, L.A. TIMES, June 24, 1990, (Calendar), at 8, 68. Unfortunately, people often fail to look at the positive messages that many rap artists express in their music. *Id.* For example, various rap artists, including Chuck D., Boogie Down Productions' KRS-One, and Kool Moe Dee, joined together to produce "Self-Destruction," a rap album calling for education and aimed at reducing the number of crimes committed by blacks against blacks. *Id.* Similarly, Hammer (formerly M.C. Hammer), Ice-T, and members of the rap group N.W.A. released the anti-gang album, *THE WEST COAST RAP ALL-STARS, WE'RE ALL IN THE SAME GANG* (Warner Bros. Records, Inc. 1990). Hilburn, *supra* at 8. Hilburn argues that, despite these efforts, society has not come to tolerate rap as it eventually did with the once-threatening rock n' roll, primarily because rap is a "black medium." *Id.* at 8.

without criticism.¹⁵² They maintain that all artists borrow from past works¹⁵³ and assert that even great composers such as Bach, Handel, and Vivaldi borrowed from preexisting works.¹⁵⁴

Sampling proponents contend that the legal community must rethink and reevaluate its concept of originality to fit modern musical

152. See *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 185 n.2 (S.D.N.Y. 1991) (noting defendant Biz Markie's argument for acquittal, which failed, that everybody else in music industry samples); see also Rule, *supra* note 7, at C13 ("Probably 99 percent of drum samples out there are not cleared . . . Everyone takes beats from other songs, adds things over them, amplifies them, does anything they have to do to make their own track.") (quoting music industry attorney Lawrence Stanley). But see *United States v. Slapo*, 285 F. Supp. 513, 513-14 (S.D.N.Y. 1968) (holding that custom and practice in music industry of using music books that illegally print song compositions do not invalidate criminal copyright laws); Considine, *supra* note 1, at 107 (stating, humorously, "as our mothers used to point out, the fact that everyone else is doing something doesn't make it right for us to do it").

153. See *supra* note 5 (discussing argument that few, if any, works of art are completely original and borrow nothing from past).

154. See PAUL HENRY LANG, *GEORGE FRIDERIC HANDEL* 561-69 (1966) (stating that music's history is filled with composers who borrowed from past works). During the English Renaissance, it was believed that "originality of real worth [could] . . . be achieved only through creative imitation." HAROLD O. WHITE, *PLAGIARISM AND IMITATION DURING THE ENGLISH RENAISSANCE* 202 (1965).

In the early twentieth century, Igor Stravinsky made an art form out of the neoclassical tradition of "borrowing" from previous materials. ROBERT P. MORGAN, *TWENTIETH-CENTURY MUSIC: A HISTORY OF MUSICAL STYLE IN MODERN EUROPE AND AMERICA* 168-79 (1991). In his 1920 ballet, "Pulcinella," Stravinsky so completely reworked music written by the eighteenth-century composer Pergolesi that Stravinsky's entire ballet was composed of portions of Pergolesi's music. *Id.* at 170-72. As Stravinsky explained, his use of previous works represented his "discovery of the past." *Id.* at 171 (quoting IGOR STRAVINSKY & ROBERT CRAFT, *EXPOSITIONS AND DEVELOPMENTS* 128-29 (1962)). Stravinsky eventually "discovered" nearly every period of Western musical history. *Id.* at 173.

Other twentieth-century composers also used previous material in their music. Charles Ives created entire vocal lines out of fragments of other people's songs. *Id.* at 143. In his 1960 opera, "Die Soldaten" (revised version, 1964), Bernd Alois Zimmermann directly quoted a Bach fugue, a Gregorian Chant, and conventional jazz figures. *Id.* at 411. Peter Maxwell Davies based almost all of his work on borrowed music from the pre-Baroque era. *Id.* at 415. This list is not exhaustive.

Many famous rock and roll musicians also have used sounds and songs created by others for their songs. For example, the Beach Boys relied so heavily on Chuck Berry's "Sweet Little Sixteen" for their song "Surfing U.S.A." that Chuck Berry was credited as a coauthor of the latter. Snowden, *supra* note 2, at 71-72. David Byrne of the Talking Heads used sounds from preachers and radio programs on his 1981 solo album, "My Life in the Bush." *Id.* at 71. Further, the Chiffons successfully sued George Harrison, claiming that he copied the melody from their song "He's So Fine" for his early 1970s hit "My Sweet Lord." *Id.* at 72.

Long before digital sampling, the music business fabricated musical acts that copied from earlier acts. Thom, *supra* note 15, at 325-26. For example, in the 1950s, the music industry was filled with "crooners" imitating Frank Sinatra's style. *Id.* In the mid-1970s, the success of the rock group KISS caused an influx of heavy metal bands "imitating their image." *Id.* at 326. In the late 1970s, when Van Halen's albums climbed the charts, a cornucopia of guitarists copied Eddie Van Halen's style. *Id.* at 325.

In sum, musicians have a history of relying on past works. As one music historian once wrote: "Tradition, where music is concerned, has no need of a capital T. In the house of music it is neither an idol nor a guest of honour nor even a steward, because here it is at home. Modest and indispensable, musical tradition is the very substance of music." Fred Goldbeck, *Twentieth-Century Composers and Tradition*, in *TWENTIETH CENTURY MUSIC* 23 (Rollo H. Myers ed., 1968).

technology.¹⁵⁵ They suggest that the public must overcome the notion that adoption of existing music is automatically unoriginal and recognize the art of reusing existing music. Ironically, while calling for a new definition of originality, samplers could also refer to the traditional common-law notions of originality that would further bolster their arguments. To be considered original under common-law doctrine, a work need only be an "independent creation," not a "novelty."¹⁵⁶ Samplers thus could argue that their works are independent creations and not just copies of older works.¹⁵⁷

On the other hand, this argument based on artistic originality might be out of place in a legal context because it has been held that "artistic originality is not the same thing as the legal concept of originality in the Copyright Act."¹⁵⁸ In *Gracen v. Bradford Exchange*,¹⁵⁹ the Seventh Circuit held that although a slight change or diversion from the original work might constitute artistic originality, it does not necessarily constitute legal originality.¹⁶⁰ Consequently, samplers' claims that their works are original and independent creations might be misplaced because they focus on artistic originality, not legal originality.

Moreover, in *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*,¹⁶¹ the Second Circuit held that a work completely identical to another work can still be considered an original, independent creation.¹⁶² The similarity, however, cannot be the result of copying.¹⁶³ This deci-

155. See Finell, *supra* note 35, at 5 (stating that one challenge facing digital sampling is applying legal definition of originality).

156. See *supra* notes 59-60 and accompanying text (explaining that author must create work using only personal artistic talents for copyright to be granted).

157. Greg Tate, *Diary of a Bug*, VILLAGE VOICE, Nov. 22, 1988, at 73 ("[M]usic belongs to the people, and sampling isn't a copycat act but a form of reanimation."); see Browne, *supra* note 151, at 54-56 (noting sophistication of sampling records due to number of different "snippets" that often appear in songs).

158. *Gracen v. Bradford Exch.*, 698 F.2d 300, 304 (7th Cir. 1983).

159. 698 F.2d 300 (7th Cir. 1983).

160. *Id.* at 304. In *Gracen*, an artist made a painting of Judy Garland as Dorothy from the movie "The Wizard of Oz" and a series of drawings. The artist then entered these works in a competition for a contract to paint collector plates. *Id.* at 301. The artist won the competition, but refused the contract and later used the paintings to solicit artistic commissions. *Id.* at 302. MGM, the owner of the movie, sued the artist, claiming that her use of the Judy Garland-as-Dorothy painting for the purpose of soliciting commissions was a violation of the movie's copyright. *Id.*

161. 558 F.2d 1090 (2d Cir. 1977).

162. *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 n.3 (2d Cir. 1977) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 10.1, at 34 (1976)).

163. *Id.* at 1092-94. *Novelty Textile Mills* involved an upholstery manufacturer that sued a competing manufacturer for allegedly infringing on the former's design. *Id.* at 1092. The court of appeals found that the main issue in the case was one of substantial copying, which may be proven by showing both access to the original design and substantial similarity between the two designs. *Id.* The court ruled that Joan Fabrics had access and that the two designs were

sion, like the one in *Taxe*,¹⁶⁴ appears to overlook questions of artistic creativity and similarity, focusing instead on the issue of actual copying to decide whether a work is original.¹⁶⁵ *Novelty Textile Mills* lends support to the argument that the dissimilarity or artistic originality of a work is irrelevant.¹⁶⁶ The fact remains that copying from another work is copyright infringement.

C. *The Debate Over the Effect of Sampling on a Song's Market*

The effect that sampling has on a song's potential market is one element courts use to decide whether the use of the song is a fair one.¹⁶⁷ It is an affirmative defense for one accused of copyright infringement to argue that the infringement did not adversely affect the market for the copyrighted song.¹⁶⁸ Given that digital samplers often borrow from older songs,¹⁶⁹ samplers argue that use of these songs does not adversely affect their potential market because the people who would buy these older songs will not buy rap albums in their place.¹⁷⁰ Therefore, even if it is conceded that sampling is a copyright infringement, it is still a fair use because it does not harm

substantially similar. *Id.* at 1092-94.

164. See *United States v. Taxe*, 540 F.2d 961, 964 (9th Cir. 1976) (holding that altering songs can still constitute illegal duplication), *cert. denied*, 429 U.S. 1040 (1977).

165. *Novelty Textile Mills*, 558 F.2d at 1092-93 (maintaining that direct copying is difficult to prove and that plaintiff may prove copying by showing defendant's access to work and substantial similarity between two works).

166. See Snowden, *supra* note 2, at 62 ("I don't deny the creativity of the people putting [sampled works] together any more than I deny the creativity of the collage artist. That doesn't change the question of whether these people have an ownership interest in the underlying works they've used.") (quoting Bruce Gold, sampling critic and attorney).

167. See *supra* note 98 (listing effect on potential market as one of four factors courts consider when determining copyright infringement under § 107).

168. See *Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845 (11th Cir. 1990) (stating that effect on market test is part of affirmative defense of fair use); *Supermarket of Homes v. San Fernando Valley Bd.*, 786 F.2d 1400, 1408-09 (9th Cir. 1986) (explaining that "affirmative defense to infringement of fair use is codified at 17 U.S.C. § 107," which includes "effect of the use upon the potential market for or value of the copyrighted work"); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1034 (N.D. Ga. 1986) (noting that effect on market test is one of four factors that provides "a framework for the court's analysis of the defendant's affirmative defense"); see also *supra* notes 110-11 and accompanying text (explaining that little to no effect on potential market for copyrighted work generally will lead to finding of fair use).

169. See Marcus, *supra* note 7, at 784 n.119 (commenting that most sampled records are old funk or rock hits); Note, *supra* note 26, at 738 n.59; *A New Bag for Hip-Hop*, NEWSDAY, Apr. 19, 1990, § II, at 11 (stating that many samplers look to civil rights era as way to connect with historical sounds of previous African-American artists). The rap and the sampled song upon which the rap is based thus attract two different age groups and listening audiences. Note, *supra* note 26, at 738 n.59. Still, rap artists have recently begun to sample fellow rappers. See Marcus, *supra* note 7, at 784 n.119 (stating that trend of rappers sampling fellow rappers is increasing).

170. See Note, *supra* note 26, at 738 n.59 (admitting that sampling usually does not damage original song's market because "song containing samples in a wholly new environment will hardly serve as a substitute for the original with the potential to dissipate its market").

the market for the original song.¹⁷¹ In fact, some argue that sampling actually helps the potential market for older songs by reviving interest in relatively forgotten music.¹⁷²

Critics of sampling could suggest, however, that a market analysis that only examines the effect on the original song is incomplete because it fails to account for the effect on other potential or derivative uses of the song.¹⁷³ For example, if the owner of an older song re-released the song as a rap version, any prior sampling would affect the market for that derivative work by potentially interfering with sales of the owner's new version.¹⁷⁴ In this way, sampling may hurt the market for protected songs, thus proving to be an unfair use of the original songs.

171. The district court in *Acuff-Rose Music, Inc. v. Campbell*, 754 F. Supp. 1150 (M.D. Tenn.), *appeal dismissed*, 929 F.2d 700 (6th Cir. 1991), *and rev'd*, 972 F.2d 1429 (6th Cir. 1992), *cert. granted in part*, 113 S. Ct. 1642 (1993), heard a claim by the owner of the Roy Orbison hit, "Oh, Pretty Woman," alleging that the rap group 2 Live Crew infringed the song's copyright when it used the song in "Pretty Woman," the group's parody of the original song. *Id.* at 1152. The district court held that 2 Live Crew's use of the Roy Orbison hit was a fair use, partly because the rap song would not likely damage the potential market for the old song. *Id.* at 1158. The court stated that the "intended audience for the two songs is entirely different. The odds of a record collector seeking the original composition who would also purchase the 2 Live Crew version are remote." *Id.* But see *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1438-39 (6th Cir. 1992) (reversing district court's decision and holding that effect-on-market-test analysis that focuses solely on fact of two different listening audiences is incomplete because it fails to consider market for derivative works as well), *cert. granted in part*, 113 S. Ct. 1642 (1993); see also *infra* note 173 and accompanying text (defining "derivative work" and explaining that effect-on-market analysis must also consider song's market for derivative works).

172. See Marcus, *supra* note 7, at 784 (admitting that sampling may help song by exposing it to wider market and re-creating interest, thereby stimulating sales); Note, *supra* note 26, at 738 (stating that original song's market is likely to dissipate after several years); Jeffrey Jolson-Colburn, *Recession or Creative Stagnation: Execs Ponder Lower Music Shipments*, BILLBOARD, Nov. 2, 1991, at 3 (citing MCA Music Entertainment Group Chairman Al Teller as noting music industry's propensity to create one-hit wonders which are quickly forgotten). Popular recording artist Billy Joel once sang, "But I know the game, and you'll forget my name and I won't be here in another year if I don't stay on the charts." *Hear BILLY JOEL, The Entertainer, on STREETLIFE SERENADE* (Columbia Records/CBS 1974). The music industry does indeed have a high attrition rate. For this reason, many older songs are forgotten. Sampling may help their sales.

173. Section 101 of the Copyright Act defines a "derivative work" as follows:

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

17 U.S.C. § 101 (1988).

The Supreme Court in *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1984), held that a fair use analysis must take into account both the effect on the market for the copyrighted work and the effect on the market for derivative works. *Id.* at 568. Thus, an analysis that focuses solely on the copyrighted work itself is flawed. *Id.*

174. The Second Circuit has held that whether an artist has any present intention of creating such a derivative work is immaterial for purposes of the effect-on-the-market test. See *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir.) (ruling that authors are entitled to protect opportunity to sell their works), *cert. denied*, 484 U.S. 890 (1987).

Furthermore, critics of sampling could argue that sampling adversely affects the potential market for musicians because it uses computerized sounds instead of studio musicians, thus replacing the need for musicians and putting them out of work.¹⁷⁵ Not only is sampling less expensive than hiring live musicians, but the digital technology also produces a better sound than that created by a live studio musician.¹⁷⁶ As a result, studio musicians have endured a sharp decline in demand for their work.¹⁷⁷

Advocates of sampling could respond by asserting that § 107 does not mention the effect on the potential market for the musician. Rather, the Act only mentions the effect on the market for the actual work.¹⁷⁸ Under this approach, while the effect on the common studio musician is unfortunate, it has no bearing on the question of fair use.

D. *The Copyright Act's Ambiguous Legislative History*

Both sides of the digital sampling debate have interpreted the language of the Copyright Act differently when arguing whether digital sampling constitutes copyright infringement. Attempting to find answers in the Act's legislative history, however, is difficult. When Congress last made major changes to the Act in 1976,¹⁷⁹ digital sampling did not exist.¹⁸⁰ Any analysis of legislative history thus can only speculate on what Congress would have done had it considered digital sampling. As a result, the Act's legislative history has spawned further debate over how Congress would have responded to digital sampling.

175. See Newton, *supra* note 33, at 712 (mentioning that sampling may damage market for musicians); McGiverin, *supra* note 32, at 1726 (positing that percussionists, bassists, and brass and string players have been hardest hit because samplers have had greatest success copying these sounds); Wells, *supra* note 32, at 700 (worrying that previously created, sampled sounds are replacing actual musicians, which may have "devastating" impact on musicians' livelihoods). McGiverin uses the artful term "self-competition" to describe how the market for these musicians is being adversely affected by their own previous recordings. McGiverin, *supra* note 32, at 1726 n.22.

176. See *supra* note 36 (describing digital sampling capabilities that allow sampler to correct pitch of notes, thereby improving sound).

177. See Newton, *supra* note 33, at 674 n.14 (pointing out that even as early as 1985, finding employment was difficult for musicians); Allan Jalon, *Will Synthesizers Put Musicians Out of Business?*, ANN ARBOR NEWS, Dec. 28, 1985, at B1 (noting statistical evidence showing that as of 1986, synthesizers were creating at least 50% of all music on television and that recording jobs for musicians had declined by about 35%).

178. See 17 U.S.C. § 107(4) (1988) (listing "the effect of the use upon the potential market for or value of the copyrighted work" as factor in fair use test) (emphasis added).

179. See Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-801 (1988)).

180. See Sanjek, *supra* note 22, at 612 (explaining that digital sampling did not enter market until 1981).

Supporters of sampling, such as prominent entertainment lawyer Ken Anderson, have said that we should "err on the side of artistic freedom."¹⁸¹ Congress has stated repeatedly that the main purpose of the Copyright Act is the public good of use and access to works of art,¹⁸² even if providing this public good comes at the expense of the author of a work.¹⁸³ Thus, sampling advocates could infer that samplers should have legal access to songs and that such access should take precedence over any monopolistic claims that the owners of those songs might assert.¹⁸⁴

Critics of sampling could respond that a public policy of allowing access to copyrighted works does not include profiting from the exploitation of another's work.¹⁸⁵ Although the policy of public

181. See Ressler, *supra* note 4, at 104 (maintaining that it is impossible to be both pro-artist and anti-sampling).

182. See *Copyright Law Revision: Hearings Before the Subcomm. on Patents, Trademarks, and Copyrights of the Senate Comm. on the Judiciary*, 89th Cong., 1st Sess. 63, 65 (1965) [hereinafter *Hearings on Copyright*] (statement of Abraham L. Kaminsstein, Register of Copyrights, accompanied by Barbara Ringer, Assistant Register) (stating that basic role of copyright law is protection of "public interest"); H.R. REP. NO. 2222, 60th Cong., 2d Sess. 7 (1909) (declaring that copyright law is "[n]ot primarily for the benefit of the author, but primarily for the benefit of the public").

183. See *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (indicating that goal of public access to works outweighs that of protection of author's ownership rights). In *Twentieth Century Music*, the Court held:

Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts. The immediate effect of our copyright law is to serve a fair return for an "author's" creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.

Id. at 156.

One legal scholar has also espoused the idea that if an author's private interests conflict with the public interest, then the latter must prevail. See ALAN LATMAN ET AL., *COPYRIGHT FOR THE EIGHTIES: CASES AND MATERIALS* 13 (1985) (recognizing that there are situations where copyright restrictions would hurt public dissemination of works and that, in those situations, "interests of authors must yield to the public welfare"); see also *Mills Music, Inc. v. Snyder*, 469 U.S. 153, 157 (1985) (stating that fundamental objective of "copyright laws requires providing incentives both to the creation of works of art and to their dissemination").

184. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 432 (1984) (stating that although immediate goal of copyright laws is to reward creators, ultimate goal is to "stimulate artistic creativity for the general public good"); Marcus, *supra* note 7, at 778 (weighing author's interest against public interest and concluding that balance should be "in favor of unrestricted expression").

185. Those who argue against sampling might point out that samplers' goal of public availability, which implies that samplers should be allowed more liberal access to others' works, ignores the fundamental distinction between re-creating the work and taking the actual sounds. See Thom, *supra* note 15, at 319 (distinguishing between legal use of musical composition and illegal use of actual sound recording). Using this argument, a law prohibiting sampling still would promote the goal of public access by allowing artists to re-make previous works; it just would not, and should not, allow use of actual sounds. The Ninth Circuit's harsh admonition against the copying of another artist's actual sounds by music pirates who made copies of others' work lends support to this argument. *Duchess Music Corp. v. Stern*, 458 F.2d 1305, 1311 (9th Cir.), *cert. denied*, 409 U.S. 847 (1972). The court stated that the infringer "may, of course, record appellant's song, when she hires musicians, artists, and technicians. Instead, she steals

access is important, Congress has also recognized that the interest of the artist is important.¹⁸⁶ Promoting the interests of artists, for example, will serve the public by creating incentives for artists to create more works of art.¹⁸⁷ Allowing digital samplers to use artists' works without permission, critics could argue, would contravene any policy that Congress has ever championed.¹⁸⁸

IV. THE CASE: *GRAND UPRIGHT MUSIC LTD. v. WARNER BROS. RECORDS, INC.*

Before December 1991, the controversy surrounding the copyright implications of digital sampling could only take the form of a debate as to what the law should be with regards to sampling. With no judicial decisions addressing the issue¹⁸⁹ and with a controlling statute that predated the development of sampling technology, the debate was necessarily and uncomfortably theoretical. On December 16, 1991, however, the Southern District of New York, "[a]fter many years of anticipation and speculation,"¹⁹⁰ announced the first judicial opinion to address the issues presented by digital sampling, *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*¹⁹¹

the genius and talent of others. She deceives others into thinking that her tapes represent her own work." *Id.* at 1311; see also *International News Serv. v. Associated Press*, 248 U.S. 215, 240 (1918) (denouncing appropriation of another's work for commercial purposes by stating that only one who has paid fair price should be allowed to use commercial property).

186. See H.R. REP. NO. 2222, 60th Cong., 2d Sess. 7 (1909) (providing that, along with promotion of public good, purpose of copyright law is also to secure "to the composer an adequate return for all use made of his composition").

187. See *Hearings on Copyright*, *supra* note 182, at 65 (statement of Abraham L. Kaminstein, Register of Copyrights, accompanied by Barbara Ringer, Assistant Register) ("[T]he most important elements of any civilization include its independent creators—its authors, composers, and artists—who create as a matter of personal initiative and spontaneous expression rather than as a result of patronage or subsidy. A strong, practical copyright law is the only assurance we have that this creative activity will continue.").

188. In fact, some in government have voiced objections to recorded cover versions of musical compositions. See *Vestron, Inc. v. ITC Prods.*, 597 N.Y.S.2d 382, 383 (App. Div. 1993) (defining "cover versions" as songs written by one artist but performed by other artists). The Register of Copyrights has stated:

The effect of this process on individual performers has been catastrophic, but the effect of this process on the nature and variety of records that are made and kept in release, and on the content and variety of radio programming, have been equally malign. Most of all it is the United States public that has suffered from this process.

S. REP. NO. 1, 94th Cong., 1st Sess. 15 (1975). If some critics have been vocal in their opposition to covers of recorded songs, it is safe to say that many would also be vocal in their opposition to digital sampling.

189. See *supra* note 26 (discussing reasons for absence of case law on subject of digital sampling).

190. Sugarman & Salvo, *supra* note 31, at 1 (stating that no court addressed sampling prior to *Grand Upright Music*).

191. 780 F. Supp. 182 (S.D.N.Y. 1991).

A. *The Factual Background*

Grand Upright Music Ltd., the alleged copyright owner of pop artist Gilbert O'Sullivan's 1972 hit "Alone Again (Naturally)," brought a copyright infringement action to enjoin all production and sales of rap artist Biz Markie's album "I Need a Haircut."¹⁹² Grand Upright Music based its claim on the fact that Biz Markie's album contained a song entitled "Alone Again" that used three words and a portion of the music from the master recording of the Gilbert O'Sullivan song.¹⁹³ Before the infringement action arose, Biz Markie's attorney had tried to get permission to use the 1972 song from Terry O'Sullivan, the artist's brother and agent, by sending a letter requesting use of the song along with a cassette copy of Biz Markie's recording.¹⁹⁴ Before the two reached an agreement, however, Biz Markie released the "I Need a Haircut" album.¹⁹⁵ Mr. O'Sullivan subsequently refused to grant permission to use the song and, after repeated demands to remove the album from the market, he filed suit.¹⁹⁶

B. *The Opinion*

The defendants in this case, Biz Markie and the record companies that produced "I Need a Haircut,"¹⁹⁷ conceded that the Biz Markie song used words and music from the Gilbert O'Sullivan song.¹⁹⁸ On the basis of this admission, the district court concluded that Biz Markie's use constituted infringement of the original song's copyright¹⁹⁹ and that the only remaining issue was whether Grand Upright Music was the true owner of the "Alone Again (Naturally)" copyright.²⁰⁰ The court ruled that Grand Upright Music was the owner of the copyright based on three categories of proof: (1) copies

192. *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991).

193. *Id.* The three words used from the Gilbert O'Sullivan song were the three words from the title, and the music used was the first eight bars of "Alone Again (Naturally)." Sugarman & Salvo, *supra* note 31, at 1, 5.

194. *See* Sugarman & Salvo, *supra* note 31, at 5 (citing Memorandum of Law in Support of Plaintiff's Motion for a Temporary Restraining Order and a Preliminary Injunction at 5, *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182 (S.D.N.Y. 1991) (No. 90-2112) [hereinafter Plaintiff's Motion]).

195. *See* Sugarman & Salvo, *supra* note 31, at 5 (citing Plaintiff's Motion at 6 and Defendant's Findings of Fact and Conclusions of Law at 10-11, *Grand Upright Music*).

196. Sugarman & Salvo, *supra* note 31, at 5.

197. *Grand Upright Music*, 780 F. Supp. at 182 (including among defendant record companies Warner Bros. Records, Inc., WEA International, Inc., Biz Markie Productions, Inc., Cool V Productions, Inc., and Cold Chillin' Records, Inc.).

198. *Id.* at 183.

199. *Id.* at 184.

200. *Id.* at 183.

of the copyrights and deeds vesting title to the copyrights in Gilbert O'Sullivan and then from O'Sullivan to Grand Upright Music;²⁰¹ (2) testimony of Gilbert O'Sullivan acknowledging Grand Upright Music as the copyright owner;²⁰² and (3) the defendants' attempt to contact Gilbert and Terry O'Sullivan.²⁰³ With regard to the third element of proof of ownership, the court held that the defendants' attempt to discuss terms for use of the song with Terry and Gilbert O'Sullivan was evidence that the plaintiff owned a valid copyright.²⁰⁴ The court reasoned that the defendants would not have attempted to discuss terms with O'Sullivan if the latter were not the copyright owner.²⁰⁵

The court further concluded that Biz Markie's use of the song violated Grand Upright Music's valid copyright to the song.²⁰⁶ As a result, the court enjoined the sale of Biz Markie's album.²⁰⁷ The court also found that the defendants intended "to sell thousands upon thousands of records" by knowingly violating the copyright.²⁰⁸ Consequently, the court referred the case to the U.S. Attorney for the Southern District of New York for possible criminal prosecution of the defendants for willful copyright infringement.²⁰⁹

201. *Id.* The court relied in part on a deed vesting original title to the copyrights in Gilbert O'Sullivan and another transferring the copyrights from O'Sullivan to Grand Upright Music in deciding that Grand Upright Music had actual ownership of the copyrights. *Id.* The defendants objected to the admission of the transferring documents on the grounds that the documents had not been filed with the Registrar of Copyrights and thus had no legal effect. *Id.* at 184. The court rejected this argument, holding that the law does not negate the effect of transferring documents simply because they were not filed with the Registrar of Copyrights. *Id.*

202. *Id.* The court concluded that O'Sullivan was a "credible" and "believable" witness and that "[t]here can be no one more interested in the question of valid copyright than a person in Gilbert O'Sullivan's position." *Id.*

203. *See id.* at 183-84 (stating that counsel for Biz Markie wrote to Terry O'Sullivan, Gilbert O'Sullivan's agent, and enclosed copy of Biz Markie song that incorporated Gilbert O'Sullivan's "Alone Again (Naturally)" and sought "terms" for use of song).

204. *Id.* at 184. The letter sent by the defendants' attorney said:

This firm represents a recording artist professionally known as Biz Markie, who has recorded a composition for Cold Chillin' Records entitled "Alone Again" which incorporates portions of the composition entitled "Alone Again Naturally" [sic] originally recorded by Gilbert O'Sullivan (the "Original Composition"). Biz Markie would like to obtain your consent to the use of the "Original Composition."

Id.

205. *See id.* (explaining that "[o]ne would not agree to pay to use the material of another unless there was a valid copyright!").

206. *Id.* at 185.

207. *Id.* The case was settled out of court a few days after the court's decision. *See* Philips, *supra* note 151, at F1. The exact amount of the settlement was undisclosed; Biz Markie and Warner Bros. Records reportedly agreed to pay a "substantial" amount of money. *Id.*

208. *Grand Upright Music*, 780 F. Supp. at 184-85 (listing evidence obtained from defendants' testimony showing that defendants knew that license was necessary).

209. *See id.* at 185 (holding that defendant may have violated 17 U.S.C. § 506(a) and 18 U.S.C. § 2319); *see also supra* note 123 and accompanying text (discussing possibility of criminal penalties for willful infringement under § 506(a) of Copyright Act). Criminal penalties for

V. THE EFFECT OF *GRAND UPRIGHT MUSIC* ON THE LAW REGARDING DIGITAL SAMPLING

A. *The Decision's Effect on the Law Regarding Digital Sampling*

There are two reasons to believe that *Grand Upright Music* will have a strong impact on digital sampling law.²¹⁰ First, the Southern District of New York, which decided *Grand Upright Music*, handles a substantial percentage of all the copyright and entertainment law cases in this country.²¹¹ The *Grand Upright Music* decision, which is binding authority on all cases that come out of the Southern District of New York, will thus serve as controlling authority on a large percentage of future digital sampling cases.

Second, because *Grand Upright Music* is the only judicial pronouncement on the issue of digital sampling, it is likely to be persuasive authority in other jurisdictions. Considering the vagueness of the outdated body of statutory law,²¹² and the lack of judicial assistance in applying the statutory law to digital sampling,²¹³ future digital

copyright infringement can result in a fine of up to \$250,000 or imprisonment for up to five years, or both. 18 U.S.C. § 2319(b)(1) (1988).

210. It is not appropriate to analyze the *Grand Upright Music* decision to determine its likely effect on digital sampling law without first discussing the decision's potential influence from a jurisdictional standpoint. If, as a matter of civil procedure, a decision has no binding authority on other jurisdictions, then an analysis of the case's merits is moot. A case from one federal district court is not binding on another district court and is only considered to be persuasive authority. See *Pennoyer v. Neff*, 95 U.S. 714, 732-33 (1878) (providing that U.S. courts "are tribunals of a different sovereignty, exercising a distinct and independent jurisdiction"); *Huffman v. Inland Oil & Transp.*, 424 N.E.2d 1209, 1212 (Ill. App. 1981) (stating that each state determines reach of its laws). *Grand Upright Music*, a district court case, is thus suspect in the sense that other district courts will not have a responsibility even to consider it. *Huffman*, 424 N.E.2d at 1212.

The influence of *Grand Upright Music* on state courts is not an issue because state courts do not handle questions of copyright law; the Copyright Act preempts all other state copyright laws and makes copyright an exclusively federal question. 17 U.S.C. § 301(a) (1988). Section 301(a) states:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

Id.

211. See Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. REV. 923, 955 (1985) (stating that New York generates large portion of copyright litigation).

212. See Copyright Act of 1976, §§ 101-116, 17 U.S.C. §§ 101-810 (1988) (failing to mention digital sampling due to fact that digital sampling did not exist at time).

213. See *supra* notes 179-80 and accompanying text (explaining lack of statutory and judicial interpretation for digital sampling due to recent introduction of digital sampling in marketplace).

sampling cases from other jurisdictions will at least address the *Grand Upright Music* decision. Other jurisdictions, therefore, may use this case as a starting point from which to rule on digital sampling simply because it is the first and only court ruling on digital sampling. For purposes of a detailed legal review of this decision, then, this Note assumes that the *Grand Upright Music* decision will influence the law.

B. How the Decision Will Influence the Law Regarding Digital Sampling

Although long awaited as the first digital sampling decision,²¹⁴ *Grand Upright Music* left many questions unanswered. One prominent entertainment lawyer said, "[T]his isn't the seminal case everyone wanted."²¹⁵ While the court ruled that Biz Markie's sampling violated the copyright law, the court failed to mention the elements necessary to prove copyright infringement, with the exception of the copyright ownership element.²¹⁶ Although the decision failed to clear up many of the theoretical legal questions regarding digital sampling, it still will have a significant impact on the music and entertainment industry.

1. The impact on the questions of law presented by digital sampling

The *Grand Upright Music* decision explicitly focuses on ownership,²¹⁷ one of the elements a plaintiff must demonstrate to prove infringement.²¹⁸ This issue, however, is not the real problem that digital sampling brings to copyright law. Observers had hoped that this case would address some of the questions that the issue of fair use²¹⁹ presents to digital sampling, such as sampling's effect on the market²²⁰ and the role of substantial similarity in a digital sampling

214. Sugarman & Salvo, *supra* note 31, at 1 (maintaining that *Grand Upright Music* will "open a new chapter in the continuing saga of sampling litigation").

215. See Stan Soocher, *As Sampling Suits Proliferate, Legal Guidelines Are Emerging*, 207 N.Y. L.J. 5, 5 (1992) (Entertainment Update) (quoting Stewart Levy, attorney for dance music producer Jellybean Benitez).

216. *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991) (holding that only issue in case was ownership of copyright).

217. *Id.* at 182-83.

218. See *supra* notes 81-83 and accompanying text (stating that owner of sound recording must demonstrate ownership in copyright suit). A plaintiff must show ownership to get standing to bring a suit of copyright infringement. See *supra* notes 81-86 and accompanying text (discussing various copyright ownership arrangements). Because ownership is a question involving the plaintiff's title to the copyright, the issue of *Grand Upright Music*'s ownership has nothing to do with Biz Markie's sampling; rather, the issue affected questions of proof regarding *Grand Upright Music*'s standing to sue. *Grand Upright Music*, 780 F. Supp. at 182-85.

219. The common thread running through the entire controversy surrounding digital sampling is the question of fair use.

220. See *supra* notes 167-78 and accompanying text (addressing debate over digital sampling's effect on original song's market for sales).

suit.²²¹ Yet, without addressing any defense of fair use issues, the court ruled that, once the plaintiff proved ownership, infringement had occurred by the simple fact that Biz Markie had sampled Gilbert O'Sullivan's song.²²²

The court's failure to discuss fair use can be interpreted in two ways. On one hand, the omission could be an intentional admonishment against the use of the fair use defense in a digital sampling case. By failing even to address the possibility that Biz Markie's use was a fair use, the court could be suggesting that the fair use defense has no place in digital sampling. If this interpretation of the court's omission is correct, then digital sampling of a song is per se infringement if the sampler fails to secure the copyright owner's permission. This approach thus would make unauthorized digital sampling a strict liability offense; questions of adverse market effects or insubstantiality become irrelevant. Mr. O'Sullivan's attorney, Jody Pope, adopts this view of the *Grand Upright Music* decision, explaining that "if a reasonable listener can recognize a sample as the work of someone else, it's enough for an infringement."²²³

On the other hand, the court's omission of fair use in its decision may derive from the fact that Biz Markie's acts so clearly amounted to an infringement that fair use was not an issue in this particular case. The court may have reasoned that Biz Markie used such a substantially similar portion of Gilbert O'Sullivan's song that the fair use defense was not available to him.²²⁴ If this interpretation explains the court's decision, then a fair use defense would still be possible in a digital sampling case that involves a more limited use of a protected song. Under this approach, unauthorized digital sampling would not constitute infringement per se. Rather, sampling would be allowed in certain limited situations where the defendant can show that the sampling of another's work constitutes fair use.

221. See *supra* notes 125-50 and accompanying text (presenting controversy over issue of substantial similarity in cases of digital sampling).

222. *Grand Upright Music*, 780 F. Supp. at 183.

223. See Soocher, *supra* note 215, at 5 (presenting various views of legal experts as to impact of *Grand Upright Music*).

224. Biz Markie took only three words from "Alone Again (Naturally)." See Sugarman & Salvo, *supra* note 31, at 5. However, the three words Biz Markie took are the lyrical refrain and the only words in the title of the original song. *Id.* The significance of the portion used clearly precludes a finding of fair use. See *supra* note 96 and accompanying text (noting that small part of work may be considered substantial if it is important and material part of work). Biz Markie also took and repeatedly used eight bars, a substantial length of music, from the Gilbert O'Sullivan song. See Sugarman & Salvo, *supra* note 31, at 1, 5 (reporting that sample from "Alone Again (Naturally)" was "looped" in order to create musical underscore for Markie's rap single). Thus, Biz Markie's use of the O'Sullivan song clearly did not warrant a fair use defense.

Grand Upright Music also fails to clarify the issue of willful infringement. In *Grand Upright Music*, the district court referred the case to the U.S. Attorney for possible criminal sanctions because it had found willful infringement.²²⁵ In particular, the defendants' actions and testimony indicated that they knew Mr. O'Sullivan owned a valid copyright.²²⁶ The court, however, omitted any discussion of whether willfulness requires a specific intent to break the law or only a broader intent to commit an act that is an infringement of a copyright.²²⁷ The fact that the defendants knew that they were sampling a copyrighted song without authorization was sufficient for the court to find the defendants guilty of copyright infringement.²²⁸ Nevertheless, the court's utter failure to explain what level of intent is needed for sampling to constitute infringement perpetuates the confusion surrounding willful infringement.

The *Grand Upright Music* decision not only fails to clarify the unresolved copyright law questions presented by digital sampling, it also fails to support its sweeping conclusions with sound legal reasoning. For example, the opinion begins with the Commandment "Thou shalt not steal."²²⁹ Yet, the core question presented by sampling is whether sampling actually is theft. This question cannot be answered adequately without consideration of the legal and theoretical underpinnings of sampling. The court based its decision solely on an analysis of the ownership question; to equate the practice of unauthorized sampling with stealing is to make a judgment based on an incomplete analysis.

Similarly, the judge opined that the defendants' "only aim was to sell thousands upon thousands of records"²³⁰ and spoke of the defendants' "callous disregard for the law."²³¹ The fact that the defendants used the work for the purpose of selling records, however, does not resolve the fair use question. A court must consider three other factors in its fair use determination.²³² The fact that the defendants in this case aimed to sell records thus is not conclusive by

225. *Grand Upright Music*, 780 F. Supp. at 185 (stating that defendants knew that they were violating plaintiff's rights).

226. *Id.* at 184-85 (referring to letter requesting consent to use "Original Composition" and admissions by defendants that they knew license from copyright holder was necessary).

227. *Cf. supra* note 124 (showing that courts differ on issue of whether willfulness requires specific or general intent).

228. *Grand Upright Music*, 780 F. Supp. at 185.

229. *Id.* at 183 (quoting *Exodus* 20:15).

230. *Id.* at 185.

231. *Id.*

232. *See supra* note 98 and accompanying text (stating that purpose of use is one of four factors in fair use inquiry).

itself.

Grand Upright Music thus suffers from inadequate legal reasoning. If the court had detailed how it reached its decision, the opinion would have provided some solutions to the legal mysteries surrounding digital sampling. Unfortunately, the court passed by this opportunity, perhaps indicating that even the courts are not clear on how the law applies to digital sampling.

2. *The impact on the music industry*

Even though the court in *Grand Upright Music* did not expressly rule out the possibility that the limited use of a song may be legal, the court's strong condemnation of unauthorized sampling²³³ could be construed as a declaration that sampling constitutes infringement *per se*. Thus, while *Grand Upright Music* provides little guidance on the legal questions of digital sampling, it will still have a major impact on the music industry because it is a strong judicial denunciation of the practice of unauthorized sampling.²³⁴ For this reason, samplers will have to alter their behavior.

After *Grand Upright Music*, sampling without consent of the copyright owner entails great risk.²³⁵ An artist who creates an unauthorized sampling, for example, faces potential criminal prosecution.²³⁶ Consequently, the decision will encourage samplers to obtain consent from copyright owners before sampling songs.²³⁷

233. See *Grand Upright Music*, 780 F. Supp. at 185 (declaring that defendants' behavior constituted "callous disregard" for law and rights of others).

234. See Philips, *supra* note 151, at F12 ("This represents the first judicial pronouncement that this practice is indeed theft.") (quoting Jody Pope, Mr. O'Sullivan's attorney). The court's invocation of the Seventh Commandment also shows that the court is denouncing unauthorized digital sampling as nothing less than theft. See *Grand Upright Music*, 780 F. Supp. at 183 (beginning decision with declaration, "Thou shalt not steal").

235. See Richard Harrington, *The Groove Robbers' Judgment: Order on 'Sampling' Songs May Be Rap Landmark*, WASH. POST, Dec. 25, 1991, at D1, D7 ("Sometimes rappers have gambled that a sample would not be recognized, or that no suits would be filed (and generally they aren't—unless an album or single is successful). Last week's ruling is likely to blunt any 'wait and see' attitudes.").

236. See *Grand Upright Music*, 780 F. Supp. at 185 (referring case to U.S. Attorney for consideration of criminal charges); see also Rule, *supra* note 7, at C18 (quoting Ms. Hope Carr of sample clearinghouse Clearance 13'-8" as saying that *Grand Upright Music* has "made everyone up-tight"). A record company executive who had been working with a band that used samples said, "Because of the Biz Markie ruling, we had to make sure we had written clearance on everything beforehand." *Id.*

237. See Rule, *supra* note 7, at C18 (quoting Mr. O'Sullivan's attorney, Jody Pope, as saying, "The effect will be that people will be careful to obtain consent and clearance before they make use of someone else's property—and isn't that the way it should be?"). Monica Lynch, president of Tommy Boy Records, also believes that *Grand Upright Music* will encourage samplers to first obtain clearance from copyright owners. *Id.* She said that the decision "will send a very direct message to artists themselves that they have a responsibility to clear samples. . . . [I]t will make labels, artists and producers a lot more cautious about making sure their t's are

Ironically, the *Grand Upright Music* decision might also discourage samplers from obtaining clearance before sampling. The court based its decision to send the case to the U.S. Attorney for consideration of possible criminal sanctions on the defendants' attempt to obtain consent from O'Sullivan before releasing "I Need a Haircut."²³⁸ This reasoning may actually discourage samplers from trying to obtain consent from copyright owners because such an attempt might later be used against them as evidence of willful infringement.²³⁹

Grand Upright Music therefore imposes a "catch-22." To escape liability, samplers are told to obtain clearance. Yet the very attempt to obtain clearance may increase the possibility of criminal prosecution for willful infringement. This absurd result may force artists to abandon sampling altogether and to explore possible alternatives.²⁴⁰ One might argue that this decision finally, and rightly, will prohibit samplers from depriving both song owners the compensation that they deserve²⁴¹ and musicians the employment that they would normally receive were it not for sampling.²⁴² At the same time, if artists cannot obtain permission from a song's owner to use a previously recorded song, they may have to return to using musicians. Hiring extra musicians or compensating a song's owner for the use of even a small portion of a protected song may then increase the costs of recording.²⁴³ In the final analysis, *Grand Upright Music* will do more than simply curb the use of a technique; it could injure rap and hip-hop music to the point of destroying an art form.²⁴⁴

crossed and their i's dotted before they put music out in the marketplace." *Id.*

238. See *Grand Upright Music*, 780 F. Supp. at 184-85 (discussing how defendants' letter to O'Sullivan's brother/agent requesting permission to use song indicated knowledge and calling for "sterner measures" for such "callous disregard" for law and rights of others).

239. See Sugarman & Salvo, *supra* note 31, at 6 (noting that licensors typically require submission of piece featuring sampling before issuing license although this process requires samplers to violate copyright law by creating piece).

240. Some prominent rap artists that are well known for their sampling have refrained from using sampling since the *Grand Upright Music* decision. For example, L.L. Cool J toured the United States with a live band and Hammer's last album contained no samples. Rule, *supra* note 7, at C18.

241. See Steve Hochman, *Judge Raps Practice of 'Sampling'*, L.A. TIMES, Dec. 18, 1991, at F1, F2 (quoting Michael Greene, President of National Academy of Recording Arts & Sciences, as saying that "[the] academy tends to fall on the side of the [songwriters] feeling they are due some consideration for their work").

242. See *supra* note 177 and accompanying text (discussing how musicians are hurt economically by sampling).

243. See Harrington, *supra* note 235, at D7 (noting that rappers have complained that original artists often ask extraordinary prices, ranging from \$500 to \$50,000, for permission to sample their songs).

244. See Philips, *supra* note 151, at F12 (quoting Dan Charnas, director of hip-hop A & R (Artists and Repertory) and promotions director at Def American Records, who believes that *Grand Upright Music* will destroy hip-hop music and culture).

VI. SOLUTIONS

A. *Congress Should Amend the Copyright Act*

Grand Upright Music's shortcomings suggest that the Copyright Act is so outdated that it simply cannot provide answers to the digital sampling problem. A revision of the Act may thus be the only solution to the sampling dilemma.

Throughout this country's history, Congress has periodically updated copyright law.²⁴⁵ Prior to 1976, Congress had not made major revisions to copyright law since 1909.²⁴⁶ Congress recognized in 1976 that extraordinary technological advances had taken place since 1909 and understood that it needed to revise the Copyright Act to meet those changes.²⁴⁷

A revision of the current copyright law to accommodate sampling would be consistent with both the Copyright Act's history of periodic adjustment due to technological advancements²⁴⁸ and the purposes of copyright law. The Copyright Act has two major objectives: securing an adequate return for the artist, and securing public access to artistic works through the prevention of monopolies.²⁴⁹ When copyright laws become outdated, new technologies escape regulation and the Act's policy goals are thwarted. The history of the 1909 revisions is an excellent illustration.

In 1909, Congress revised the Copyright Act in response to recent technological advances in the mechanical reproduction of music, notably, the advent of player pianos that used paper music rolls.²⁵⁰

245. See H.R. REP. NO. 1476, 94th Cong., 2d Sess. 47 (1976), *reprinted in* 1976 U.S.C.A.N. 5659, 5660 (commenting that comprehensive revisions to 1790 copyright act occurred in 1831, 1870, and 1909).

246. See *id.* (noting that several revisionary efforts between 1924 and 1940 failed).

247. See *id.* (citing advances in communication of printed matter, information storage, communications satellites, and laser technology as prompting change).

248. See BOORSTYN, *supra* note 53, at 1-2 n.2 (stating that Congress extended protection to prints, musical compositions, photographs, art, motion pictures, and sound recording at different intervals).

249. See *supra* notes 182-88 and accompanying text (discussing two primary policies behind copyright law).

250. See RUSSELL SANJEK & DAVID SANJEK, *AMERICAN POPULAR MUSIC BUSINESS IN THE 20TH CENTURY* 12 (1991) (discussing transformation of rights and privileges of American composers, songwriters, authors, and publishers, and noting Copyright Act of 1909 as principal catalyst for change). Piano mechanic John McTammany patented the player piano in 1850 but did not have the means to market it. *Id.* at ix. It was not until 1899 that William B. Tremaine, who purchased the patent rights from McTammany, introduced a marketable self-playing piano. *Id.* Soon after, Tremaine sold 75,000 player pianos and a million music rolls. *Id.*

The other technological innovation in the mechanical reproduction of music that helped spawn the 1909 Act was the phonograph. *Id.* at 12. In 1896, Eldridge Reeve Johnson, in conjunction with Emile Berliner, invented the Victrola, a motor-powered phonograph that improved the sound of earlier hand-cranked machines. *Id.* at viii. Between 1901 and 1909,

The Aeolian Company signed exclusive agreements with eighty-seven music publishers to produce piano rolls in return for a ten percent royalty on the retail price.²⁵¹ Soon after President Theodore Roosevelt learned of this unregulated monopoly in 1907, Congress saw the need to revise the law to address the new technology.²⁵² The 1909 Act eventually mandated a two cent royalty for each piano roll manufactured.²⁵³

Like the production of piano rolls, the advent of digital sampling is a change in technology that requires congressional response.²⁵⁴ The Copyright Act of 1976 never considered the technology of sampling;²⁵⁵ the Act thus provides courts with little guidance on sampling.²⁵⁶ The decision in *Grand Upright Music* reflects this lack of legislative guidance and highlights the outdated nature of the Act. A legislative change in the existing law would reduce lawsuits by eliminating this uncertainty and would put to rest the debate over the legality of sampling.

production of recorded products increased from 3,750,000 to 27,500,000. *Id.*

251. *See id.* at 12 (explaining that James F. Bowers, president of Music Publishers Association, had been instrumental in convincing 87 Association members to grant exclusive piano-roll recording rights to Aeolian).

252. *See id.* (stating that certain new provision of Copyright Act of 1909 originated from attention President Roosevelt and industry competitors dedicated to it). President Roosevelt actually appealed to Congress to change the Act prior to 1907. In a 1905 address to Congress, he said:

Our copyright laws urgently need revision. They are imperfect in definition, confused and inconsistent in expression; they omit provision for many articles which, under modern reproductive processes, are entitled to protection; they impose hardships upon the copyright proprietor which are not essential to the fair protection of the public; they are difficult for the courts to interpret. . . . A complete revision of them is essential.

ALAN LATMAN ET AL., COPYRIGHT FOR THE EIGHTIES 7 (2d ed. 1985).

253. Copyright Act, ch. 320, § 1, 35 Stat. 1075, 1076 (1909).

254. In 1976, Congress amended the Copyright Act in response to technological advances in such fields as printed-matter publication, information storage, communications satellites, and laser technology. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 47 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5660. Digital sampling technology is as important a breakthrough as these other technologies. Sampling has revolutionized the music industry in that many big-name artists use sampling technology. *See supra* note 6 and accompanying text (discussing increase of sampling due to advent of rap genre). Furthermore, it has greatly enhanced the average person's ability to experiment with music. *See supra* notes 47-48 and accompanying text (noting that decrease in price of sampling equipment has increased artists' access to sampling).

255. *See supra* notes 14-24 and accompanying text (discussing how Copyright Act is unequipped to deal effectively with current digital sampling technology because digital sampling was not in existence at time of 1976 revision).

256. *But see* H.R. REP. NO. 1476, 94th Cong., 2d Sess. 66 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5680 (stating that courts must decide whether to invoke fair use doctrine on case-by-case basis).

B. Congress Should Institute a Compulsory Licensing Provision for Digital Sampling

Copyright law's two competing policy goals, public access to works of art and protection of copyright owners' rights to profit,²⁵⁷ are diametrically opposed objectives.²⁵⁸ For example, a prohibition on sampling would disregard the policy of access to others' works. At the same time, allowing unrestricted unauthorized sampling would compromise the copyright owners' interests in seeking an adequate return on their works. To achieve the optimal balance between these two goals, the law should take the middle ground.

A modified compulsory licensing system for digital sampling is one solution that has the potential to satisfy both policy interests. The current compulsory licensing provision under § 115 of the Act strikes a balance between the two competing copyright goals.²⁵⁹ Section 115 compels a copyright owner to grant another artist a license to "cover" her song,²⁶⁰ an approach that furthers the goal of public access by allowing anyone to obtain access to a song. Section 115 also mandates that the person using the protected song pay compensation to the copyright owner,²⁶¹ thus furthering the goal of protecting owners.

Presently, the Act grants a compulsory license only for covers, which are re-creations of songs by different musicians.²⁶² Congress should extend the Act's coverage to sampling and to the use of the actual sounds. Both sampling and the covering of songs are forms of art that take previous works and put them in new contexts;²⁶³ one uses the musical composition, while the other appropriates the sound recording. The principle is the same, however, in that they both use past works.²⁶⁴ Thus, compulsory license provisions should govern

257. See *supra* notes 182-88 and accompanying text (presenting congressional, judicial, and scholarly opinions regarding policies behind copyright laws).

258. See *supra* notes 182-88 and accompanying text (revealing that samplers support access and sampling critics support protection).

259. See 17 U.S.C. § 115 (1988) (guaranteeing public access to works through compulsory licensing, while insuring copyright owner royalty payments).

260. See *id.* § 115(a) (requiring licensee to serve notice of compulsory license on copyright owner in order to receive such license).

261. See *id.* § 115(c) (stating that owner is "entitled to royalties" to be determined either by number of works used or minutes of playing time).

262. *Id.* § 115(a).

263. See *supra* note 154 (presenting support for argument that digital sampling puts older works into new context just like other forms of art).

264. Originally, the purpose of distinguishing actual sounds from the musical composition and of forbidding the re-recording of actual sounds was to prevent tape "piracy," which is the unauthorized re-recording of an original work. See *United States v. Taxe*, 380 F. Supp. 1010, 1014 (C.D. Cal. 1974) (holding that § 1(f) of 1971 Sound Recording Act, precursor to §§ 114 and 115 of 1976 Copyright Act, forbids re-recording of actual sounds yet grants compulsory

both covering and sampling.²⁶⁵ Such a provision would further the

license for musical compositions), *aff'd in part and vacated in part*, 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977). The court in *Taxe* held, however, that the purpose was not to prevent "trivial re-recording[s]" or re-recordings that have been substantially changed so that the original is unrecognizable. *Taxe*, 380 F. Supp. at 1014. Songs that use digitally sampled material fall within these two categories that Congress, at least according to *Taxe*, did not intend to prevent when it drafted the distinction between actual sounds and musical compositions. Samplers' music, which usually appropriates very small portions of other songs, thus might qualify as "trivial re-recordings." See Soocher, *supra* note 215, at 26 (quoting Ken Anderson, counsel for Beastie Boys, as saying "We're dealing in a world of minutia with sampling because most samples are very small portions of pre-existing recordings."). Furthermore, samplers often change the sounds that they borrow so that they are not easily recognizable. See Goldberg & Bernstein, *supra* note 36, at 2 (claiming alteration of sounds is limited only by imagination); Houle, *supra* note 32, at 881 (stating that individual can "vary, delete or reverse certain tonal qualities"); McGiverin, *supra* note 32, at 1725 (discussing alteration of sample by replacing codes, moving placement of sounds, adding or deleting entire arrangements, and muting or augmenting individual instruments). The whole purpose of providing a compulsory license for the musical composition but not for the sound recording was to prevent piracy, not digital sampling.

265. Some artists have even argued that having a compulsory licensing provision for musical compositions, while not having one for sound recordings, is a violation of due process under the Fourteenth Amendment. In *Shaab v. Kleindienst*, 345 F. Supp. 589 (D.D.C. 1972), the plaintiff filed suit to enjoin the Attorney General from prosecuting him under the criminal provisions of the Copyright Act. *Id.* at 590. The plaintiff claimed that failure to provide for a compulsory license for sound recordings "gives rise to an invidious discrimination against one who like himself is subject to compulsory licensing of his musical compositions." *Id.* The district court rejected this argument, ruling that distinguishing between musical compositions and sound recordings, in terms of compulsory licenses, is both "rational and reasonable." *Id.* The court explained that the compulsory license provision for musical compositions promotes the arts by allowing for different interpretations of a written composition. *Id.* A compulsory license provision for sound recordings, however, would not yield the same public benefits because "[c]onsumer choices would not be broadened since identical interpretations would be supplied first by the originator and later by the licensee." *Id.*

Similarly, in *United States v. Bodin*, 375 F. Supp. 1265 (W.D. Okla. 1974), defendants indicted for selling copies of sound recordings made the same argument asserted by the plaintiff in *Shaab*: "The lack of adequate provisions for compulsory licensing . . . for sound recordings while providing the same . . . for musical compositions is a direct denial of due process which discriminates between the rights of a recording company and of legitimate sound recording distributors." *Id.* at 1268. The District Court for the Western District of Oklahoma rejected the defendants' Fourteenth Amendment argument, relying almost exclusively on *Shaab*. *Id.* at 1268-69 (quoting *Shaab*).

In *Shaab* and in *Bodin*, the courts rejected the due process argument because society would not receive the same public benefits under a compulsory license provision for sound recordings as it does under a compulsory license provision for musical compositions, namely the potential for different artistic interpretations of a single musical work. See *Bodin*, 375 F. Supp. at 1268 (finding court's reasoning in *Shaab* persuasive and quoting that language at length); *Shaab*, 345 F. Supp. at 590 (stating that instead of different artistic interpretations, compulsory licensing of sound recordings would not broaden consumer choices and, in fact, would impair competition and creativity of industry). These arguments do not hold true anymore in light of the fact that digital sampling became available in 1983, years after these early 1970s cases. See Sanjek, *supra* note 22, at 612 (explaining that first MIDI synthesizer, which facilitated modern sampling, appeared on market in 1983). Digital sampling allows for different reanimations of old songs, not just duplicative recordings. See McGiverin, *supra* note 32, at 1725 (discussing how digital sampling can correct pitch, move sounds, add or delete whole sections, and mute or augment single instruments). A compulsory licensing provision for sound recordings would thus permit more than one artistic interpretation of a composition. For this reason, the *Shaab* court's rationale for rejecting the constitutional argument is outdated. Thus, a due process claim may now be valid.

Act's two policy goals. A compulsory license provision for sampling would help samplers by guaranteeing them access to songs. At the same time, it would protect song owners by assuring them compensation for use of their songs.

This proposal would also make unauthorized sampling illegal and unnecessary because samplers would enjoy guaranteed use of a song.²⁶⁶ Moreover, the law should not penalize samplers for attempting to obtain a license from a song owner. If approaching a song owner to obtain a license is not used as evidence of infringement against the defendant in a copyright suit, samplers will be encouraged to try to obtain consent first.

CONCLUSION

In modern musical culture, digital sampling has emerged as a popular technique for exploring and reexamining older music. Because the sampling phenomenon is more far-reaching in its technological capabilities than any previous musical technology, sampling has transcended the scope of the existing law, forcing lawyers, musicians, and others in the music entertainment business to analyze this new musical technique in a legal vacuum, and leaving them only to speculate as to how the old law applies to sampling. As a result, much debate and controversy among those interested in the entertainment law field have produced a whole spectrum of opinions on digital sampling's place in the law. In fact, even the judiciary appears confused and undecided on how the law should treat sampling, as evidenced by the *Grand Upright Music* decision.

The law, however, cannot ignore the new technology of digital sampling or dismiss it as a fad devoid of artistic value. Digital sampling is a form of art that the law must not forbid. At the same time, the law must regulate samplers to protect song owners from unauthorized copyright use. Congress needs to change the Copyright Act to accommodate sampling, just as it has done in the past to accommodate other new technologies. A compulsory licensing provision that guarantees compensation is an ideal solution for amending the Act in that it satisfies the interests of both the public

266. Some samplers may argue that this proposal would increase their expenses by forcing them to pay for the use of samples. See Harrington, *supra* note 235, at D7 (noting rappers' argument that artists often charge extraordinary prices to sample their songs). Use of another's song, however, warrants compensation. It would be unfair to guarantee access to samplers and not guarantee compensation to song owners. Perhaps one solution to the problem of extraordinarily high prices would be to implement a pay scale for the use of a song based on the size of the portion taken from the song. This approach would guarantee compensation to the owner in proportion to the amount of the song used.

and the artist and creates a framework that can accommodate future technologies still unforeseen.